



AT

IFW 3728

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Daniel Pellerin

Group Art Unit: 3728

Serial No.: 09/771,416

Examiner:

Filed: January 26, 2001

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For: UNIVERSAL CLEAT

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**PETITION FOR EXERCISE OF THE  
COMMISSIONER'S SUPERVISORY AUTHORITY**

**Introduction**

This is a petition seeking exercise of the Commissioner's supervisory authority to require the examiner to recognize that the drawings submitted with a patent application constitute a portion of the disclosure of the patent application and that such drawings constituting a portion of the disclosure may be used as a basis, in whole or in part, for claims in the patent application.

## Statement of Facts

This patent application was filed 26 January, 2001 and accorded serial number 09/771,416. The application as filed constituted five pages of descriptive specification, nine claims, an abstract and two sheets of drawings having twelve drawing figures thereon.<sup>1</sup>

The application disclosed and claimed cleats for athletic shoes, with the cleats being suited for use as baseball cleats and, most importantly, with the cleats being useable as replacement baseball cleats for athletic shoes produced by a number of different manufacturers. Hence, the "Universal Cleat" title of the application.

In a first official action dated 6 March, 2002<sup>2</sup>, the examiner objected to the drawings as failing to comply with 37 C.F.R. 1.84(p)(5) on the basis that two reference numerals appearing in the written description did not appear in the drawings. Additionally, the examiner rejected all of the claims as allegedly being obvious in light of the prior art.<sup>3</sup>

In response on 6 June 2002, applicant submitted an amendment, making a minor change to dependent claim 5 and traversing the Examiner's characterization of the references and what the references allegedly disclosed.<sup>4</sup>

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<sup>1</sup> A copy of the application as filed is attached as Exhibit "A."

<sup>2</sup> A copy of the 6 March 2002 official action is attached as Exhibit "B."

<sup>3</sup> The examiner contended that United States patent 5,058,292 taken in view of United States patent 4,590,693 rendered the claims obvious, since the '292 patent allegedly disclosed a universal cleat suitable for use with multiple different baseball shoes, where the shoes had recesses in the soles for receiving cleats, and each cleat included a generally triangular base with a substantially flat bottom for fitting into a plurality of different shaped recesses in different shoes, and further contending that '693 disclosed a baseball shoe having a threaded opening therein for receiving a retaining screw to hold the cleat in place and to allow for easier replacement of the cleat. From this, the Examiner asserted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a threaded opening in the recess of '292 for receiving a retaining screw as taught by '693 for easier replacement of cleats.

<sup>4</sup> A copy of the 6 June 2002 amendment is attached as Exhibit "C".

On 9 September 2002, the Examiner issued a final rejection of the claims<sup>5</sup>. In the final rejection, the Examiner adhered to his previous position as to the disclosures of the '292 and '693 references. In his conclusory statement maintaining the rejection of the claims the Examiner stated that: "It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a threaded opening in the recess of '292 for receiving a retaining screw as taught by '693 for easy replacement of the universal cleats."

In response to this final rejection, on 16 May 2003 Applicant filed a conditional notice of appeal and an amendment after final rejection. Accompanying the amendment after final rejection were several statements from buyers of products, represented by applicant as embodying the invention. In those statements the buyers attested to the advantages provided by the replacement cleat that was the subject of the invention, in that the universal characteristic of the replacement cleat allowed such buyers to service all of their replacement cleat business with a single item.

In further response to the final rejection, Applicant proffered text to be added to the specification, describing the shoes and their cleat receptacles shown in Figures 8 through 11 of the drawings that accompanied the application when filed. The text sought to be added to the description of the invention portion of the application merely put into words what one sees when looking at the drawings of the shoes, more specifically parts of the bottoms of the soles of four shoes, that were depicted in Figures 8, 9, 10 and 11 of the application as filed.<sup>6</sup>

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<sup>5</sup> A copy of the 9 September 2002 official action is attached as Exhibit "D."

<sup>6</sup> The text sought to be added to the application, describing the structure shown in Figures 8 through 11, is attached as Exhibit M.

In the 16 May 2003 submission, Applicant also sought to add new claims 10 through 26 reciting the structure of the bottoms of the shoes shown in Figures 8, 9, 10 and 11 as filed with the application, so as to define more specifically the environment for the claimed cleats and in which the claimed cleats functioned.<sup>7</sup> One day later, the 16 May 2003 Amendment was followed by a Request For Continued Prosecution.

In response to the Request for Continued Prosecution and the Amendment After Final Rejection, on 31 July, 2003 the Examiner issued an Official Action allowing claims 4 through 7 and 9 but rejecting claims 1 through 3, 8 and 10 through 26. Newly added claims 10 through 26 were rejected as allegedly failing to comply with the written description requirement, with the Examiner asserting that those claims contained

[S]ubject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) at the time the application was filed had possession of the claimed invention. In claim 10, lines 12-13 and claim 11, lines 40-41, the limitation “with a longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses” and claim 15, lines 6-7, the limitation “with a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses,” and claim 18, lines 6-7, the limitation “with the longest side being shorter than the longest of any of said straight line sides of the recesses,” claim 19, lines 13-14, the limitation “the longest side of said three sides of said base being shorter than the shortest side of any said triangular recesses,” and claim 23, lines 8-9, the limitation “along the side of said three sides of said base being shorter than the shortest side of any of said triangular recesses” or new matter. These limitations are not described to the specification in such a way as to reasonably convey to one skilled in the relevant art that the Inventor(s) at the time the Application was filed had possession of the claimed invention.<sup>8</sup>

The portions set forth in quotation marks by the Examiner, in the text reproduced above, are what the Examiner cited in support of the rejection for alleged failure to comply with the written description requirement, and include the

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<sup>7</sup> A copy of the 16 May 2003 Amendment After Final Rejection is attached as Exhibit “E.”

<sup>8</sup> A copy of the Official Action of 31 July 2003 is attached as Exhibit “F.”



precise words Applicant had added to the written description portion of the application to describe the structure shown in Figures 8 through 11.

In response to the 31 July 2003 official action, Applicant made minor amendments to the rejected claims to clarify those claims and argued strenuously that the Examiner's action, in rejecting claims 10 through 26 under 35 U.S.C. 112, paragraph 1 as failing to comply with the written description requirement, was error. Applicant noted that those claims were supported by the original specification in a way to reasonably convey to one skilled in the art that the inventor was in possession of the claimed invention at the time the application was filed because the subject matter recited in those claims was clearly shown in the drawings filed as a part of the original application.

Applicant further noted that drawing-supported amendments to the written description portion of a patent application do not constitute new matter and cited the Manual of Patent Examining Procedure, Section 2163.07 and *In re Reynolds*, 443 F. 2d 384 (CCPA 1971). Applicant further quoted from the *Reynold* opinion, noting that *Reynolds* held it was permissible and appropriate to rely on the drawings filed as a part of the original disclosure to find support for claim amendments. Applicant also proffered other arguments in support of the patentability of the claims.<sup>9</sup>

On 8 April, 2004, the Examiner issued a Notice of Non-Compliant Amendment as respecting the amendatory paper dated 2 February, 2004, whereupon on 13 April, 2004 Applicant sent a corrective "Amendments to the Claims" section to replace the defective pages of the February 2, 2004 Amendment.

On 13 July 2004, the Examiner issued an official action responding to the corrected February 2, 2004 paper. In that action, the Examiner repeated the previously

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<sup>9</sup> A copy of Applicant's Response Paper of 2 February, 2004 is attached hereto as Exhibit "G."

issued claim rejections based on alleged new matter as represented by the descriptive material that had been added in the paper of 2 February 2004 to describe the structure shown in Figures 8 through 11 filed with the application, and made the rejection “final”. The 13 July 2004 official action was silent as respecting applicant’s arguments, proffered in the 2 February 2004 paper, as to why the descriptive material was properly added to the specification, merely described the structure shown in the drawings that were filed with the application, and was not new matter. The Examiner ignored the MPEP section and the case law authority, namely *In re Reynolds*, cited by Applicant in the 2 February, 2004 paper.<sup>10</sup>

In response, Applicant filed a paper dated 15 November, 2004, canceling rejected claims 1 through 3, 8 and 10 through 26 without prejudice. Applicant further amended the paragraphs that had been previously added to the application by applicant’s amendment of 20 May 2003, to enhance the internal consistency of the vocabulary used in the text and the clarity of the itself.<sup>11</sup>

On 2 February 2005, the Examiner issued another official action, withdrawing the finality of the rejections set forth in the official action of 13 July 2004, noting that the 17 November 2004 amendment after final rejection had not been entered. The Examiner further withdrew the previously indicated allowability of claims 4 through 7 and 9 in view of newly discovered references and further noted that the 19 May 2003 Request for Continued Examination was acceptable and that Continued Examination had been established.

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<sup>10</sup> A copy of the 13 July 2004 official action is attached as Exhibit “H”.

<sup>11</sup> A copy of applicant’s 15 November 2004 paper is attached as Exhibit “I.”

In the 2 February 2005 action Examiner again repeated, for the third time, the rejection of claims 10 through 26 as failing to comply with the written description requirement. The Examiner again asserted, for the third time, that these claims contained subject matter that was not described in the specification. The rejection was a word-for-word repeat of the rejection in the 13 July 2004 Official Action and the rejection of 31 July, 2003. Once again, the Examiner did not consider the Applicant's position regarding the drawings being a part of the disclosure and therefore providing a basis for Applicant's new claims and claim amendments. The Official Action was silent as respecting the case of *In re Reynolds*, which had been thoroughly discussed in applicant's papers of 16 May 2003 and 2 February 2004.<sup>12</sup>

On 2 August 2005, applicant responded to the official action of 2 February 2005 and presented additional authority for the proposition that the text added to the application was permissible because it only described the structure shown in the drawings filed with the application. Applicant again argued on the basis of *In re Reynolds*, that the addition of the text describing the structure appearing in Figures 8 through 11 originally filed with the application did not add new matter to the application.<sup>13</sup>

On 20 October, 2005, the Examiner issued a final rejection of all claims pending in the application, again repeating verbatim, in the detailed action section of the official action, the basis for rejecting claims 10 through 26 as allegedly containing "subject matter not described in the specification in a way as to reasonably convey to one skilled

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<sup>12</sup> A copy of the Official Action 2 February, 2005 is attached as Exhibit "J."

<sup>13</sup> A copy of applicant's paper of 2 August 2005 is attached as Exhibit "K"

in the relevant art that the inventors, at the time that the application was filed, had possession of the claimed invention.”<sup>14</sup>

Applicant has filed a notice of appeal.

### **Argument and Relief Requested**

Applicant seeks to invoke the Commissioner’s supervisory authority to require the examiner to recognize as established law that the drawings filed as a part of a patent application constitute a part of the disclosure of the subject matter to which the application is directed. Applicant further seeks to invoke the Commissioner’s supervisory authority to require the examiner to consider, on the merits, the text applicant has sought to add to the application, presenting written description of the structure appearing in Figures 8 through 11 of the application as filed.

On the first point, namely that the drawings constitute a part of the disclosure of the subject matter to which a patent application is directed and hence that the drawings can serve as a basis for claims in the application, whether those be claims filed with the application or added to the application during prosecution, the law is well established and uniformly supportive of that position.<sup>15</sup> Accordingly, the Examiner should be required to recognize this well-established principle of law and should be required to acknowledge that drawing Figures 8 through 11, filed with the application, constitute a part of the

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<sup>14</sup> A copy of the Official Action of 20 October, 2005 is attached as Exhibit “M.”

<sup>15</sup> *In re Reynolds* 443 F.2d 384, 58 CCPA 1287; 170 USPQ 94 (CCPA 1971); *Shaffer Tool Works v. Joy Manufacturing Company* 424 F. Supp. 1269; 193 USPQ 115 (S.D. Tex. 1976); *Kennecott Corporation v. Kyocera International, Inc.* 835 F.2d 1419; 5 USPQ2d 1194 (Fed. Cir. 1987); *Breen and Lauterbach v. Cobb and Jackson* 487F2d 558; 179 USPQ 733 (CCPA 1973); *Cooper Cameron Corp. v. Kvaerner Oilfield Products, Inc.*, 291 F.3d 1317, 1322, 62 USPQ2d 1846 (Fed. Cir. 2002); *Modine Mfg. Co. v. U.S. Int’l Trade Comm’n*, 75 F.3d 1545, 1556, 37 USPQ2d 1609, 1617 (Fed. Cir. 1996), *cert. denied sub nom*; *Showa Aluminum Corp. v. Modine Mfg. Co.*, 518 U.S. 1005 (1996); *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 866, 26 USPQ2d 1767, 1774 (Fed. Cir. 1993)

disclosure of the application taken as a whole, which may be used to support new claims and claim amendments during the course of prosecution of the application.

As respecting the second request, namely that the Commissioner's supervisory authority be invoked to require the examiner to permit the amendments to the written description of the invention that describe the subject matter disclosed in Figures 8 through 11, the Commissioner's attention is respectfully directed to Figures 8 through 11 and the specification of the application as filed. Even the briefest perusal of the application as filed reveals that the structure shown in Figures 8 through 11 is not discussed in the written description portion of the application.

The structure disclosed in Figures 8 through 11 consists of the forward portions of shoe soles with cleat receptacles therein formed of simple geometric shapes, namely triangles with rounded vertices, with the sides of the triangles in some cases including insets relative to the rounded vertices. That structure is clearly and simply described in the text that applicant's counsel sought to add to the specification of the application. For the convenience of the Commissioner, that text is set forth in Exhibit M hereto.

Applicant respectfully invites the Commissioner to read the text set forth in Exhibit M against the structure illustrated in Figures 8 through 11 of the application as filed. From that reading it will be apparent that the text describes the structure shown in Figures 8 through 11, and nothing more. The text does not embellish or add to what is shown in Figures 8 through 11. The text only puts into words what the eye sees when looking at Figures 8 through 11. The text does not add any new matter to the application. The text only puts into words the structure shown in the drawings.

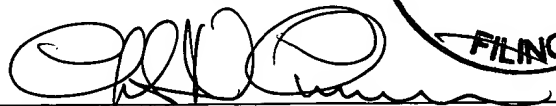
In light of this, the examiner's repeated refusal to even consider the text applicant sought to add to the application, putting into words the structure shown in Figures 8 through 11, was an error. This error continues to deprive applicant of the right to solicit claims using the description of the structure shown in Figures 8 through 11 to define the environment in which the baseball cleat subject matter of the invention functions.

For these reasons, the Commissioner should order the examiner to permit the application to be amended by addition of the text describing the structure of Figures 8 through 11, as set forth in Exhibit M, and furthermore should order the examiner to permit applicant to solicit claims directed to cleats functioning within the environment defined by the structure of Figures 8 through 11 as set forth in the text to be added to the application.

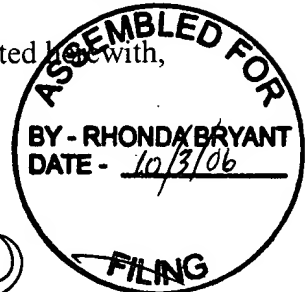
Applicant solicits issuance of an appropriate directive to the Examiner, along the lines set forth in the preceding seven paragraphs.

To the extent there is any fee required in connection with the receipt, acceptance and/or consideration of this paper and/or any accompanying papers submitted herewith, please charge all such fees to deposit account 50-1943.

Respectfully submitted,



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Date: 30 OCTOBER 2006

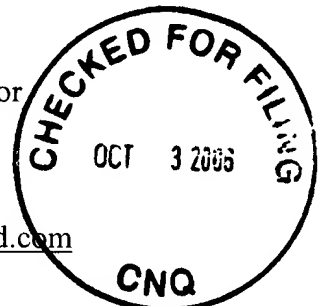
**CERTIFICATE OF MAILING  
UNDER 37 C.F.R. 1.8(a)**

I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date indicated below, with sufficient postage, as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
(signature)

BY: RHONDA BRYANT

DATE: OCTOBER 3, 2006



UNIVERSAL CLEAT

by

Daniel Pellerin

CROSS-REFERENCE

This application is related to U.S. Design Patent Application Serial No. \_\_\_\_\_, filed by Francois Duval, entitled CLEAT, which is filed on even date herewith, and which is incorporated herein by reference, Attorney Docket No. 13493-1.

BACKGROUND

The present invention relates to cleats for athletic shoes, and particularly baseball cleats.

A problem for sporting goods retailers is that there are many different types of cleats. The cleats are typically removably mounted in a recess in the sole of a baseball shoe being held in place with a retaining screw that extends through a circular retainer hole in the cleat into a threaded opening in the recess. Manufacturers of baseball shoes, such as Nike, Easton, Adidas, and Reebok, each have their own proprietary cleat. These cleats differ in shape, sometimes have projections on the bottom, and have the retainer hole located in different places. Thus, the cleat of one manufacturer usually does not fit the shoe of a competitor.

This requires a retailer of baseball shoes to carry multiple different types of cleats. This creates inventory problems, and also leads to problems for the customer, because many times retailers do not have an adequate supply of the cleats from every manufacturer.

Attempts to carry just one type of cleat from one manufacturer have been unsuccessful because the cleats from one manufacturer generally do not fit into the recesses in the soles of the baseball shoes of another manufacturer. One reason for this is the belief that the cleats must snugly fit into the recess so that there is no wiggle, with the cleats retained firmly in place, even without the retaining screw.

Thus, from the retailer's and customers' standpoint, it would be desirable to have a universal cleat that could be used with the baseball shoes of multiple manufacturers.

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#### SUMMARY

The present invention is directed to a cleat that satisfies this need. A cleat according to the present invention is universal in that is suitable for use with multiple different types of shoes, such as baseball shoes, from different manufacturers. Such shoes have a recess in the sole for receiving a cleat. The recess has an opening therein for receiving a retaining screw to hold the cleat in place. The universal cleat comprises a generally triangular base with a substantially flat bottom for fitting in a plurality of different shaped recesses in different shoes. There is a grip projecting from the base in a plane substantially perpendicular to the plane of the base, and an oblong shaped mounting hole in the base for receiving the retaining screw.

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20 Preferably the cleats are sized so that the perimeter of the base is smaller than the perimeter of the respective recess so that in the absence of the retaining screw, the cleat can wiggle in the recess. Preferably the length to the width of each mounting hole is from about 8:7 to about 10:7, and most preferably is about 9:7.

25  
30 Surprisingly, it has been found that even though the cleats of the present invention have a flat bottom base, and thus no projections for engagement with the bottom of the shoe recesses, are sized to provide wiggle room, and use an oblong shaped hole instead of a circular hole, the cleats perform well in use. It has been found that the retaining screw itself sufficiently retains the cleat in place to give optimum performance to a baseball shoe, without all the other retention mechanisms provided by manufacturers. Thus, retailers and baseball players can maintain a supply of only a single type of cleat, namely, the universal cleat of the present invention, rather than maintaining an inventory of two or more different types of cleats.



### DRAWINGS

These and other features, aspects and advantages of the present invention will become better understood from the following description, appended claims, and accompanying drawings where:

5           FIG. 1 is a perspective view of a cleat according to the present invention, with the cleat being upside down from its position when in use;

          FIG. 2 is a side elevation view of the cleat of FIG. 1, where the side elevation view of the opposite side is a mirror image of FIG. 2;

          FIG. 3 is a front elevation view of the cleat of FIG. 1;

10          FIG. 4 is a rear elevation view of the cleat of FIG. 1;

          FIG. 5 is a top plan view of the cleat of FIG. 1;

          FIG. 6 is a bottom plan view of the cleat of FIG. 1;

          FIG. 7 is a sectional view of the cleat of FIG. 1 taken on line 7-7 in FIG. 3;

15          FIGS. 8-11 are perspective views of the recesses on the bottom of Reebok, Easton, Adidas, and Nike baseball shoes, respectively, for receiving a cleat; and

          FIG. 12 is a perspective view of another version of a cleat according to the present invention.

### DESCRIPTION

20           With reference to FIGS. 1-11, a cleat 10 according to the present invention is useful with any of the baseball shoes 12A, 12B, 12C, and 12D shown in FIGS. 8-11, respectively. The particular shoes 12 shown in the  
25          drawings are baseball shoes, but it should be recognized that cleat 10 according to the present invention can be used with other types of athletic shoes.

          As is typical with baseball shoes, there are a plurality of recesses 14 in the sole 16 of the shoe. The recesses 14A, 14B, 14C, and 14D of shoes 12A, 12B, 12C, and 12D, respectively, differ from each other. Because of this,  
30          a cleat that is specifically designed for each of the shoes does not fit in a recess of any of the other shoes. As shown in FIGS. 8-11, each recess is provided with a threaded opening 18 therein for holding a cleat in the recess by means of a threaded fastener 20.

The cleat 10 comprises a generally triangular base 22 with a flat bottom 24, and a grip 26 projects upwardly from the base 22 in a plane substantially perpendicular to the plane of the base 22. The grip 26 engages the turf. Because the bottom 24 of the base 22 is flat and the base 22 is triangular shaped, it can fit into different size recesses 14, including recesses that have indents for receiving grips extending from the base as in conventional cleats.

The grip 26 has a front face 27 with a cutout 28 therein. Only the bottom portion of the cutout 28 is required in the present invention, i.e., the portion of the cutout 28 that is at the level of the base 22. The remaining portion of the cutout 28 is for decorative purposes. The bottom portion of the cutout 28 is needed to accommodate retaining projections 30 that are present in some shoe recesses, such as those of FIGS. 8 and 9.

There is an oblong shaped mounting hole 32 in the base 22 for receiving the fastener 20. The mounting hole is oblong shaped to accommodate the fact that the mounting holes in the shoe shown in FIGS. 8-11 are not all in the same location relative to the periphery of the base 22. The ratio of the length "L" to the width "S" (see FIG. 5) of the mounting hole is from about 8:7 to about 10:7, and preferably is about 9:7. If the ratio is too small, not enough different types of baseball shoes can be accommodated; if the ratio is too large, the structure of the cleat is unduly weakened.

The mounting hole 32 comprises a central rectangular section 32a and two end radiused sections 32b.

Unlike conventional cleats/baseball shoes configurations, the surface area of the base 22 of the cleat is generally smaller than the surface area of the respective recess so that in the absence of the retaining fastener, the cleat wiggles in the recess. For example, the surface area of the cleat can be from 85 to 95% of the surface area of the recess. This is a result of designing a universal cleat.

The materials used to construct the cleat 10 are the type typically used for such cleats. More particularly, in the version of the invention of FIG. 1, a metal insert 34 provides reinforcement in the critical stress area, i.e., where the fastener holds the cleat against the shoe sole. Preferably the metal used is cold rolled steel that is chromate treated. The rest of the cleat is molded from a durable rigid polymeric material, such as nylon PA 6-6 available from DuPont.

In an alternate version of a cleat 10A of the invention shown in FIG. 12, the insert 34A and grip 26A are a single metallic piece, providing a stronger gripping portion of the cleat. The metal can be cold rolled steel that is chromate treated.

5                    Preferably, baseball shoes are fitted out totally with cleats of the present invention. However, it is recognized that since for the most part the cleats of the present invention are used as replacement cleats, and there are occasions when only some of the cleats are replaced. Thus, conventional cleats and the cleats of the present invention can be used on a single athletic shoe.

10                   Exemplary of the dimensions of a cleat of the present invention is a height of about 14 millimeters from the top of the grip to the bottom of the base 22, with the base 22 having a height "h" of about 5 millimeters (see FIG. 7).

15                   Although the present invention has been described in considerable detail with reference to certain preferred versions thereof, other versions are possible. Therefore, the scope of the appended claims should not be limited to the description of the preferred versions contained herein.

20                   All features disclosed in the specification, including the claims, abstracts, and drawings, and all the steps in any method or process disclosed, may be combined in any combination, except combinations where at least some of such features and/or steps are mutually exclusive. Each feature disclosed in the specification, including the claims, abstract, and drawings, can be replaced by alternative features serving the same, equivalent or similar purpose, unless expressly stated otherwise. Thus, unless expressly stated otherwise, each  
25                   feature disclosed is one example only of a generic series of equivalent or similar features.

30                   Also, any element in a claim that does not explicitly state "means for" performing a specified function or "step for" performing a specified function, should not be interpreted as a "means" or "step" clause as specified in 35 U.S.C. § 112.

What is claimed is:

1. A universal cleat suitable for use for multiple different  
baseball shoes, the shoes having a recess in the sole for receiving a cleat, the  
5 recess having a threaded opening therein for receiving a retaining screw to hold  
the cleat in place, the cleat comprising:
  - (a) a generally triangular base with a substantially flat  
bottom for fitting into a plurality of different shaped  
10 recesses in different shoes;
  - (b) a grip projecting from the base in a plane  
substantially perpendicular to the plane of the base;  
and
  - (c) an oblong shaped mounting hole in the base for  
15 receiving the retaining screw.
2. The cleat of claim 1 wherein the area of the base is smaller  
than the area of the recesses so that in the absence of the retaining fastener, the  
cleat can wiggle in the recess.
- 20 3. The cleat of claim 1 wherein the ratio of the length of the  
mounting hole to the width of the mounting hole is from about 8:7 to about  
10:7.
- 25 4. A baseball shoe comprising:
  - (a) a sole;
  - (b) multiple recesses in the sole sized for receiving a  
cleat;
  - (c) a threaded opening in each recess;
  - (d) a cleat mounted in at least some of the recesses, at  
30 least one cleat being a universal cleat comprising (i)  
a generally triangular base with a substantially flat  
bottom, (ii) a grip projecting from the base in a plane  
substantially perpendicular to the plane of the base,

and (iii) a mounting hole in the base, at least one of the mounting holes being oblong shaped; and

- (e) a retaining fastener for each cleat extending through the mounting hole and threaded into the respective threaded opening for retaining the respective cleat in place.

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2  
cleat  
5. The shoe of claim 4 wherein the area of the base of each universal is smaller than the area of the respective recess so that in the absence  
10 of the retaining fastener, the cleat wiggles in the recess.

6. The shoe of claim 4 wherein the ratio of the length of each oblong shaped mounting hole to the width of the oblong shaped mounting hole is from about 8:7 to about 10:7.

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7. The shoe of claim 4 wherein all of the cleats are universal cleats.

8. The cleat of claim 2 wherein the area of the base is from  
20 85 to 95% of the area of the recess.

9. The shoe of claim 5 wherein the area of the base is from 85 to 95% of the area of the recess.

**ABSTRACT**

A universal cleat suitable for use for multiple different baseball shoes comprises a generally triangular base with a substantially flat bottom for fitting into a plurality of different shaped recesses in different shoes. There is a  
5 grip projecting from the base in a plane substantially perpendicular to the plane of the base. The base has an oblong shaped mounting hole for receiving a retaining screw.

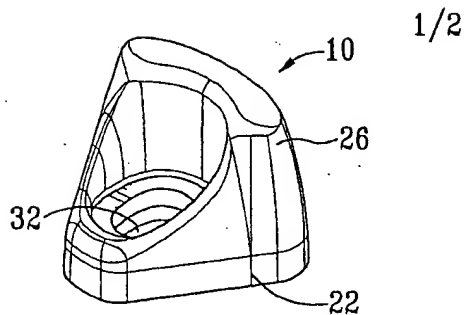


FIG. 1



FIG. 2

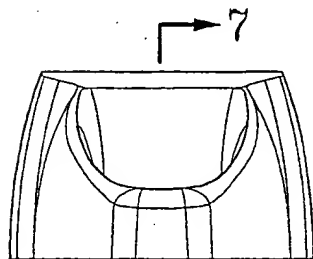


FIG. 3

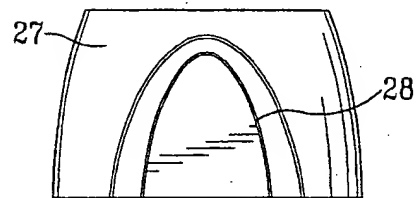


FIG. 4

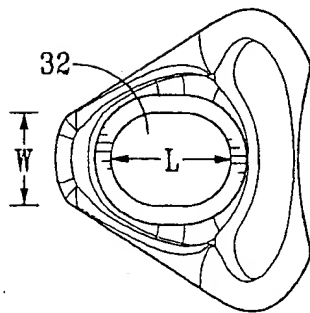


FIG. 5

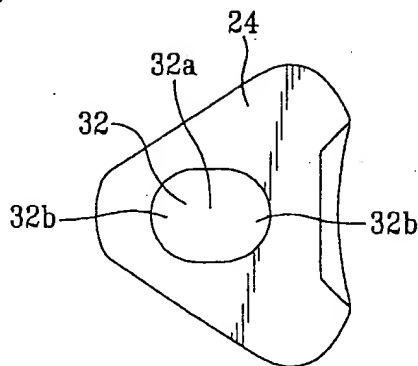


FIG. 6

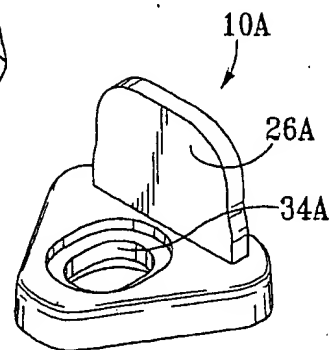


FIG. 12

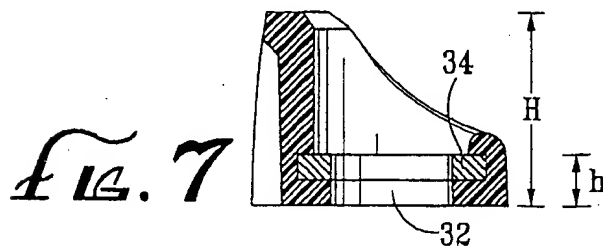


FIG. 7

2/2

7

FIG. 8

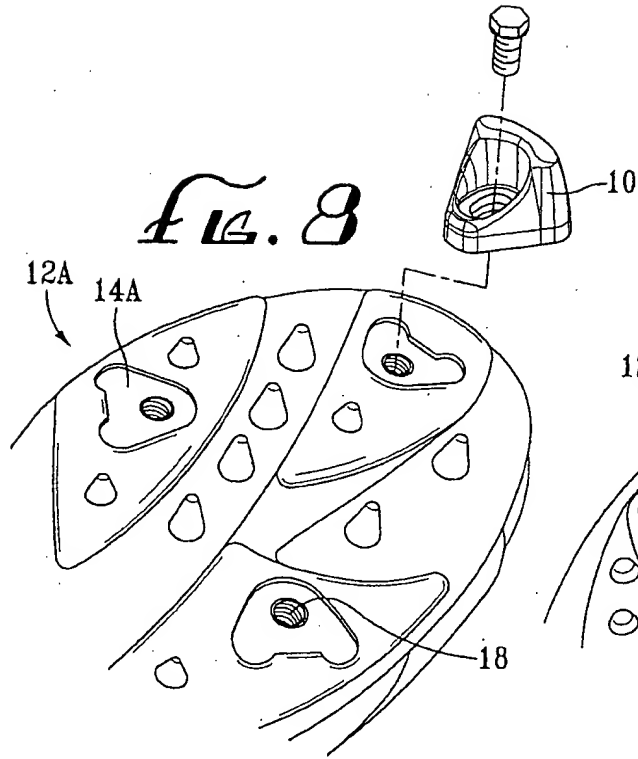


FIG. 9

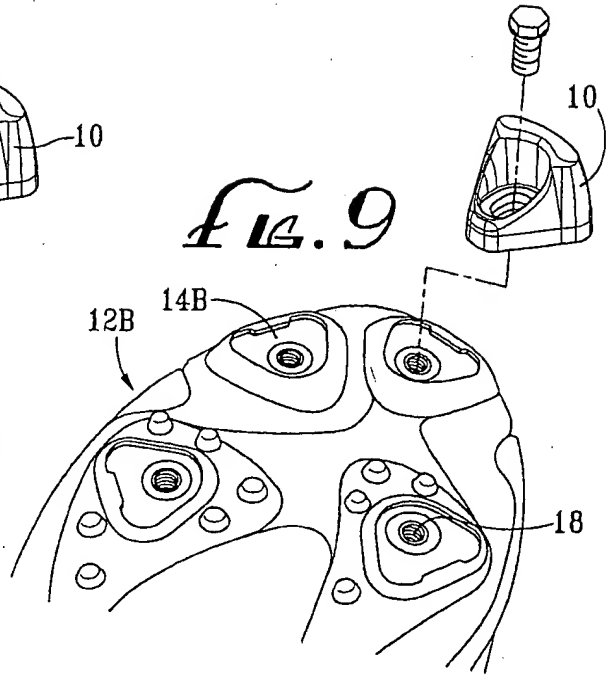


FIG. 10

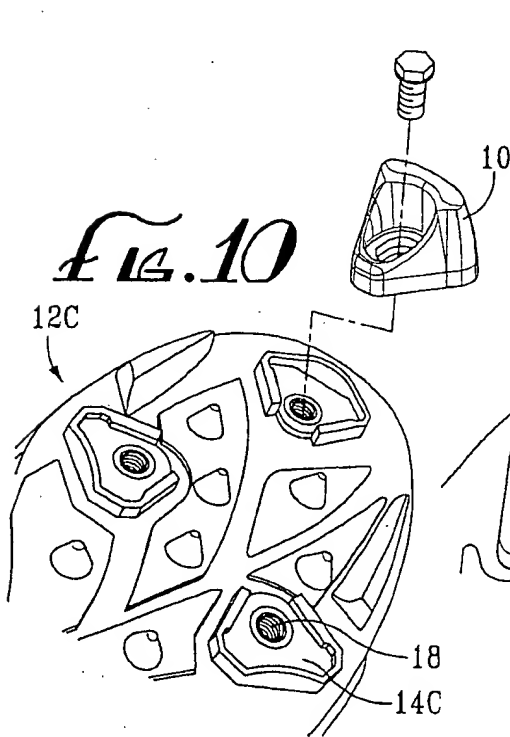
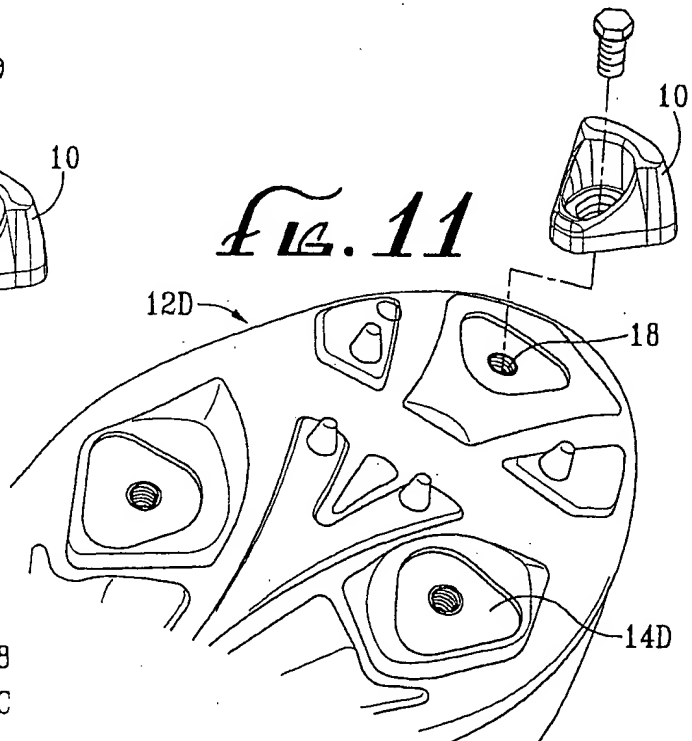


FIG. 11







# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,416	01/26/2001	Daniel Pellerin	13493	6341

7590 03/06/2002  
SHELDON & MAK  
Suite 900  
225 South Lake Avenue  
Pasadena, CA 91101

EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
----------	--------------

3728

DATE MAILED: 03/06/2002

*Response due 6/6/02*

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/771,416

Applicant(s)

PELLERIN, DANIEL

Examiner

Jila M. Mohandesi

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference no. 16 and reference no. 20. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanel (5,058,292) in view of Kawashima et al. (4,590,693). Tanel '292 discloses an universal cleat suitable for use for multiple different baseball shoes, the shoes having a recess in the sole (column 8, lines 63-66) for receiving a cleat, the cleat comprising a generally triangular base (11) with a substantially flat bottom for fitting into a plurality of different shaped recesses in different shoes (column 9, lines 1-3); a grip (13) projecting from the base in a plane substantially perpendicular to the plane of the base; and a mounting hole (29) in the base, the mounting hole can have any convenient shape (column 7, line 6-8). Tanel '292 does not appear to have a threaded opening in the recess for receiving a retaining screw to hold the cleat in place. Kawashima '693 discloses a baseball shoe having a recess (5) with threaded opening (4) therein

Art Unit: 3728

for receiving a retaining screw (9) to hold a cleat (8) in place and allow for easier replacement of the cleat. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a threaded opening in the recess of Tanel '292 for receiving a retaining screw as taught by Kawashima '693 for easier replacements of the universal cleats.

With respect to claims 2, and 5 the universal cleat will inherently wiggle in the recess in the absence of the retaining fastener.

With regard to claims 3 and 6, the ratio of the length of the mounting hole to the width of the mounting hole would be a design choice depending on the shape and size of the mounting hole.

With regard to claims 8 and 9, the relationship between the area of the base and the area of the recess will depend on the type and size of shoes being used.

### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is cited on PTO-892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is 703-305-7015.

The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Application/Control Number: 09/771,416

Page 4

Art Unit: 3728

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Jila M. Mohandesi

Examiner

Art Unit 3728

JMM

February 28, 2002

  
**J. Mohandesi**  
**Patent Examiner**

FORM PTO-1449		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTORNEY DOCKET NO.: 13493		SERIAL NO.: N/A		J0825 U.S. PTO 09/771416
<b>LIST OF ART CITED BY APPLICANT</b> (Use Several sheets if necessary)				APPLICANT: Daniel Pellerin				
				FILED: Herewith		GROUP: N/A		

U.S. PATENT DOCUMENTS							
Examiner Initial*	A1	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING D. IF APPROP
gr	A1	6,018,893	02/01/00	Workman	36	134	04/03
	A2						
	A3						
	A4						
	A5						
	A6						
	A7						
	A8						
	A9						
	A10						
	A11						

FOREIGN PATENT DOCUMENTS												
A12	A13	A14	A15	A16	A17	DOCUMENT NUMBER	INVENTOR	DATE	COUNTRY	CLASS	SUBCLASS	TRANSL. YES

OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)	
A18	Photographs of cleats by Nike, Easton, Adidas, and Reebok
A19	

EXAMINER	DATE CONSIDERED 2-27-2
----------	---------------------------

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and considered. Include copy of this form with next communication to applicant.

**Notice of References Cited**

Application/Control No.

09/771,416

Applicant(s)/Patent Under  
Reexamination  
PELLERIN, DANIEL

Examiner

Jila M. Mohandesi

Art Unit

3728

Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-US006041461A	03-2000	Ogawa et al.	12/146R
	B	US-5,628,129A	05-1997	Kilgore et al.	36/134
	C	US-5,058,292A	10-1991	Tanel	36/126
	D	US-4,590,693A	05-1986	Kawashima et al.	36/126
	E	US-3,040,450A	06-1962	Phillips	36/126
	F	US-2,006,637A	07-1935	Goldenberg	36/59R
	G	US-1,923,365A	08-1933	Gaines	36/126
	H	US-1,055,229A	03-1913	Rogers	36/64
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

09/771,416

Attorney Docket No. 13493

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

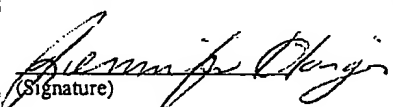
In re Application of: ) Group Art Unit: 3728  
Daniel PELLERIN )  
Serial No.: 09/771,416 ) Examining Attorney: Jila M. Mohandesi  
Filed: January 26, 2001 )  
For: UNIVERSAL CLEAT )  
Pasadena, California

RESPONSE AND AMENDMENT

CERTIFICATE OF MAILING (37 CFR 1.8)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington D.C. 20231 on June 6, 2002.

(Date)

  
(Signature)

Jennifer Hargis  
(Typed Name)

Box No Fee  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

In response to the Office Action dated March 6, 2002, please amend the above-identified application as follows:



**IN THE CLAIMS:**

Amend claim 5 as shown in the attachment. The claims after amendment are as follows:

1. A universal cleat suitable for use for multiple different baseball shoes, the shoes having a recess in the sole for receiving a cleat, the recess having a threaded opening therein for receiving a retaining screw to hold the cleat in place, the cleat comprising:

- (a) a generally triangular base with a substantially flat bottom for fitting into a plurality of different shaped recesses in different shoes;
- (b) a grip projecting from the base in a plane substantially perpendicular to the plane of the base; and
- (c) an oblong shaped mounting hole in the base for receiving the retaining screw.

2. The cleat of claim 1 wherein the area of the base is smaller than the area of the recesses so that in the absence of the retaining fastener, the cleat can wiggle in the recess.

3. The cleat of claim 1 wherein the ratio of the length of the mounting hole to the width of the mounting hole is from about 8:7 to about 10:7.

4. A baseball shoe comprising:

- (a) a sole;
- (b) multiple recesses in the sole sized for receiving a cleat;
- (c) a threaded opening in each recess;
- (d) a cleat mounted in at least some of the recesses, at least one cleat being a universal cleat comprising (i) a generally triangular base

with a substantially flat bottom, (ii) a grip projecting from the base in a plane substantially perpendicular to the plane of the base, and (iii) a mounting hole in the base, at least one of the mounting holes being oblong shaped; and

- (e) a retaining fastener for each cleat extending through the mounting hole and threaded into the respective threaded opening for retaining the respective cleat in place.

5. (Amended) The shoe of claim 4 wherein the area of the base of each universal cleat is smaller than the area of the respective recess so that in the absence of the retaining fastener, the cleat wiggles in the recess.

6. The shoe of claim 4 wherein the ratio of the length of each oblong shaped mounting hole to the width of the oblong shaped mounting hole is from about 8:7 to about 10:7.

7. The shoe of claim 4 wherein all of the cleats are universal cleats.

8. The cleat of claim 2 wherein the area of the base is from 85 to 95% of the area of the recess.

9. The shoe of claim 5 wherein the area of the base is from 85 to 95% of the area of the recess.

#### REMARKS

Claims 1-9 are in this application. All the claims presented were rejected under 35 U.S.C. §103. Reexamination, reconsideration, and allowance is respectfully requested.

### DRAWINGS

The drawings were objected to for not having reference number 16 and 20. Enclosed is a copy of the drawings with those reference numbers added in red. Approval of the proposed drawing correction is respectfully requested. Upon indication of allowable subject matter, formal drawings to replace the corrected drawings will be submitted.

### AMENDMENT TO THE CLAIM

Entry of the amendment to the claim is respectfully requested. It adds no new matter, in that a missing word was inadvertently not included. A complete set of the claims with the amendment as entered is provided herewith.

### REJECTION UNDER 35 U.S.C. §103

The present invention is directed to a universal cleat, so that a single cleat can be used with the baseball shoes provided by different manufacturers. Different manufacturers have developed their own proprietary cleats, where the cleat of one manufacturer usually does not fit the shoe of a competitor. This requires the retailer of baseball shoes to carry multiple different types of cleats, which creates inventory problems, and leads to problems for the customer, because many times retailers do not have an adequate supply of the cleats from every manufacture.

Applicant solved this problem by providing a cleat that has a generally triangular base with a substantially flat bottom so that it can fit into a "plurality of different shaped recesses in different shoes". There is a grip projecting from the base in a plane substantially perpendicular to the plane of the base. The base has an oblong shaped mounting hole for receiving a retaining screw.

This invention was rejected over the combination of Tanel U.S. Patent No. 5,058,292 in view of Kawashima et al. U.S. Patent No. 4,590,693. This rejection is respectfully traversed.

In particular, it is respectfully submitted that a prima facie case of obviousness has not been made because:

1. Contrary to the assertion in the Office Action, Tanel does not teach a cleat suitable for multiple different baseball shoes. The reference to column 9, lines 1-3 of Tanel is misplaced. What Tanel says there is:

“To simplify the manufacturing function, it is preferred that cleat 10 be formed to be useful on shoe sizes ranging from about size 7 through about size 17.” (Emphasis added).

This is not what is claimed by applicant. Applicant has invented a cleat that is useful for shoes from different manufacturers which have “different shaped recesses”. Neither references suggests a manufacturer changes the shape of a recess in going from one shoe size to another.

2. Neither of the references applied teaches an “oblong” shape mounting hole as required by the claims. As the Examiner notes, all that Tanel states is that the mounting hole can have any “convenient shape”. It is only by hindsight reconstruction that one would know that a “convenient shape” needs to be “oblong” to achieve the purposes of applicant’s invention. There is absolutely no suggestion or teaching in either Tanel or Kawashima et al. to make the opening oblong. Note that Tanel only specifically teaches a triangular opening, while Kawashima et al. has a circular opening.
3. As correctly noted by the Examiner, Tanel does not have a threaded opening. And to make the opening of Tanel threaded as suggested in the office action would be completely contrary to the teachings of Tanel. Tanel teaches mounting a cleat by bonding it with a bonding material. See column 8, lines 55-68. The sole purpose of Tanel’s aperture 29 is for “further securing cleat 10”. (Column 8, lines 62-63). There is no suggestion or teaching by Tanel that the

aperture 29 can be used for a retaining screw. Only by hindsight reconstruction is it possible to take the teaching of Kawashima et al. and apply it to Tanel.

### CLAIMS 2 AND 5

Applicant also wishes to direct specific special attention to claims 2 and 5. These claims note that due to the universal nature of the cleat it is smaller than the area of respective recess so that in the absence of the retaining fastener, the cleat wiggles in the recess. This feature is not taught or suggested by either reference. In fact Kawashima et al. teaches the opposite of it. See Kawashima et al. at column 2 which it teaches that the L-shaped spikes 8 have bases 7 with a lower surface flush with rim 6 when the bases 7 are fitted in recesses, followed by threaded screw 9 into internally threaded fitting 4. Kawashima et al. specifically state:

“With this arrangement, when a lateral force is exerted on the spikes 8, the rim 6 prevent the spikes from moving relative to the sole. Because of the close engagement of the bases 7 of the spikes 8 with the rim 6, any soil cannot enter the recesses 5.”

(Column 2, lines 18-23). (Emphasis added).

“Close engagement” leaves no wiggle room.

We note that in the Office Action it is stated:

“With respect to claims 2 and 5 the universal cleat will inherently wiggle in the recess in the absence of the retaining fastener.”

That is of course true, and that is exactly what is claimed, and not suggested by the references cited, and contrary to the teachings of Kawashima et al.

### CONCLUSION

For the foregoing reasons, it is believed the present application is in condition for allowance. Such allowance is respectfully requested.

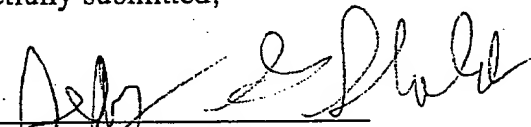
If there are any remaining issues to be resolved, it is suggested that a telephone call be placed to the undersigned. It is our experience that telephone interviews can often lead to early disposal of pending applications.

No fee is believed to be due in connection with this communication. If, however, any fee is determined to be due, the Commissioner is authorized to charge payment the fee to Deposit Account No. 19-2090.

Respectfully submitted,

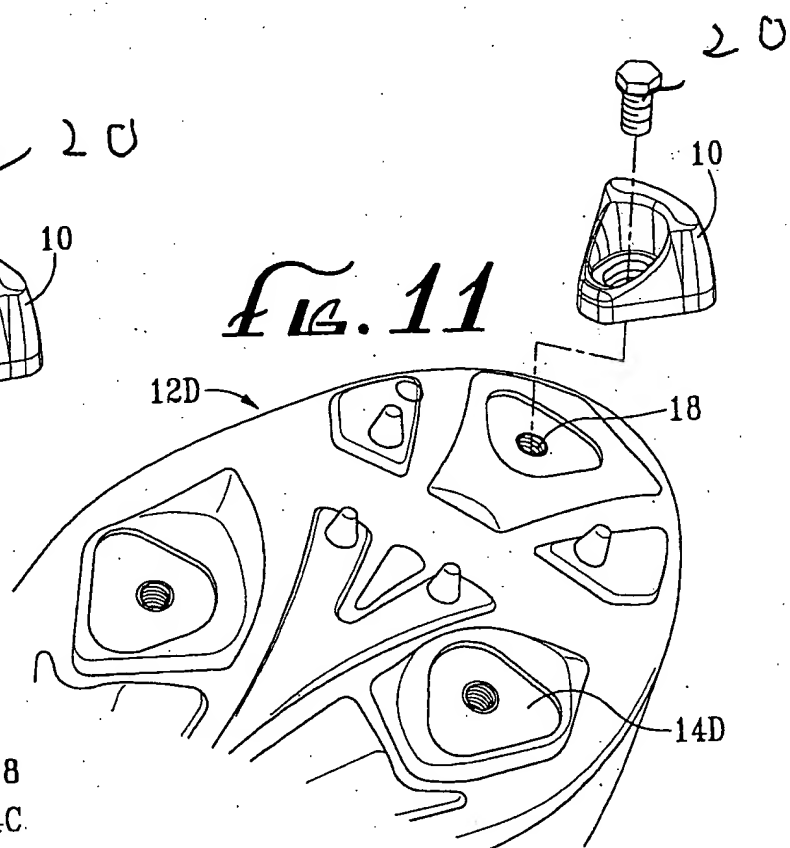
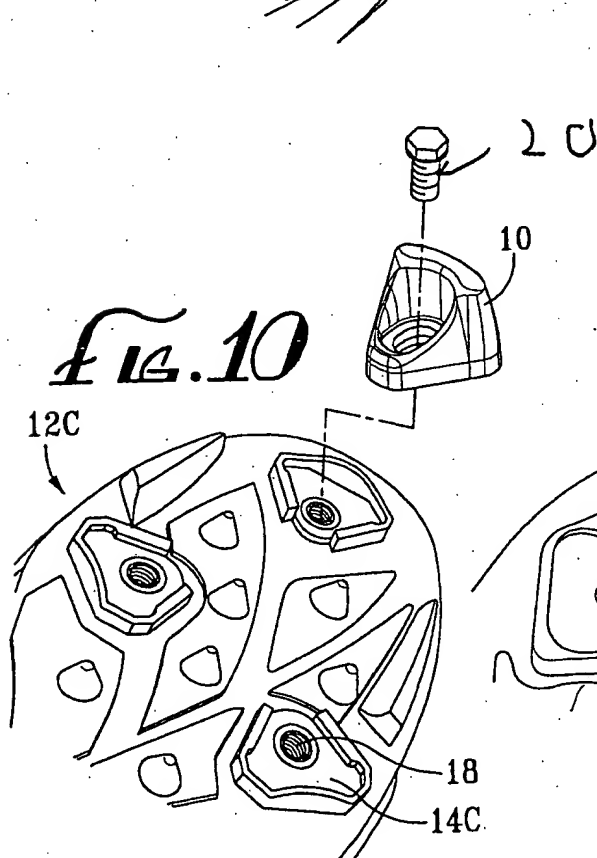
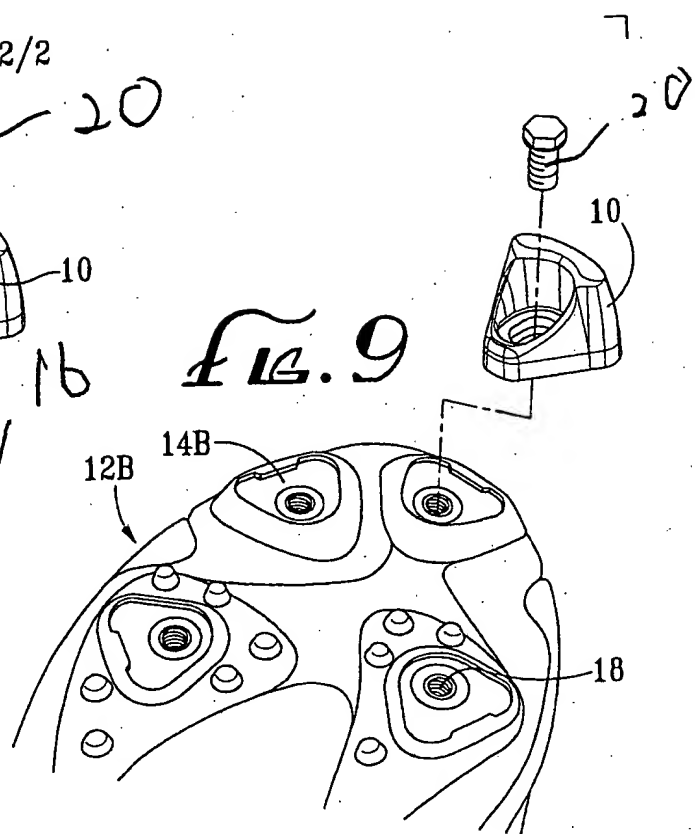
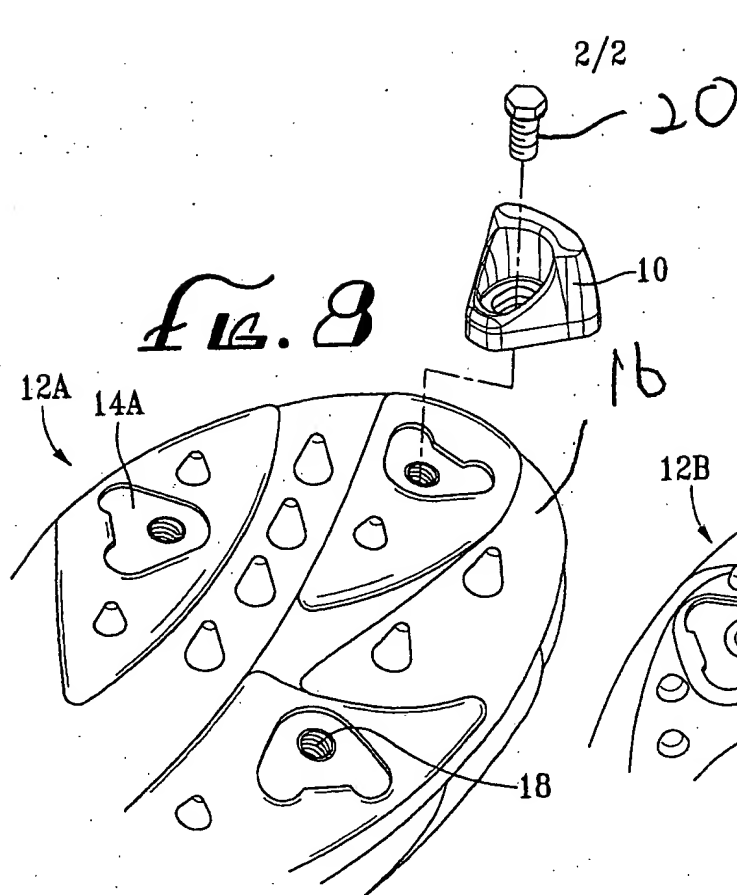
Date: June 5, 2002

By

  
Jeffrey G. Sheldon  
Reg. No. 27,953

**MARKED UP VERSION OF AMENDMENT TO CLAIM SET**

5. The shoe of claim 4 wherein the area of the base of each universal cleat is smaller than the area of the respective recess so that in the absence of the retaining fastener, the cleat wiggles in the recess.





13493



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,416	01/26/2001	Daniel Pellerin	13493	6341

7590

09/09/2002

SHELDON & MAK  
 Suite 900  
 225 South Lake Avenue  
 Pasadena, CA 91101

EXAMINER

MOHANDESI, JILA M

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 09/09/2002

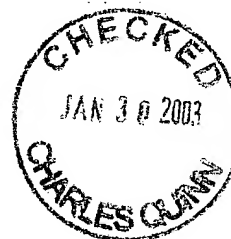
Final O/A dated 9/9/02.  
 2nd Month Response due 11/12/02.  
 6th Month Response due 3/10/03.

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED

JAN 29 2003

SHERRY BARAG



# Office Action Summary

Application No.

09/771,416

Applicant(s)

PELLERIN, DANIEL

Examiner

Jila M Mohandesi

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
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## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 14 June 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanel (5,058,292) in view of Kawashima et al. (4,590,693). Tanel `292 discloses an universal cleat suitable for use for multiple different baseball shoes, the shoes having a recess in the sole (column 8, lines 63-66) for receiving a cleat, the cleat comprising a generally triangular base (11) with a substantially flat bottom for fitting into a plurality of different shaped recesses in different shoes (column 9, lines 1-3); a grip (13) projecting from the base in a plane substantially perpendicular to the plane of the base; and a mounting hole (29) in the base, the mounting hole can have any convenient shape (column 7, line 6-8). Tanel `292 does not appear to have a threaded opening in the recess for receiving a retaining screw to hold the cleat in place. Kawashima `693 discloses a baseball shoe having a recess (5) with threaded opening (4) therein for receiving a retaining screw (9) to hold a cleat (8) in place and allow for easier replacement of the cleat. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a threaded opening in the recess of Tanel `292 for receiving a retaining screw as taught by Kawashima `693 for easier replacements of the universal cleats.

With respect to claims 2, and 5 the universal cleat will inherently wiggle in the recess in the absence of the retaining fastener.

With regard to claims 3 and 6, the ratio of the length of the mounting hole to the width of the mounting hole would be a design choice depending on the shape and size of the mounting hole.

With regard to claims 8 and 9, the relationship between the area of the base and the area of the recess will depend on the type and size of shoes being used.

It would have been an obvious matter of design choice to modify the length and weight of the mounting hole and area of the base and the recess, since such a modification would have involved a mere change in the size and shape of the component. A change in size and shape is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

### ***Response to Arguments***

3. Applicant's arguments filed June 14, 2002 have been fully considered but they are not persuasive.

In response to applicant's argument that the present invention is directed to a universal cleat, so that a single cleat can be used with baseball shoes provided by different manufactures, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference

as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the above references are directed to different attachment means for attaching a cleat to a baseball shoe. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a threaded opening in the recess of Tanel `292 for receiving a retaining screw as taught by Kawashima `693 for easier replacements of the universal cleats.

#### **Conclusion**

**4. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3728

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the Tech Center 3700 Customer Service Center number is (703) 306-5648. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner cannot confirm receipt of faxes) Please identify Examiner Mohandesi of Art Unit 3728 at the top of your cover sheet of any correspondence submitted. Inquiries only concerning the merits of the examination should be directed to Jila Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337. Check out our web-site at "www.uspto.gov" for fees and other useful information.

Application/Control Number: 09/771,416  
Art Unit: 3728

Page 6

Jila M. Mohandesi  
Examiner  
Art Unit 3728

JMM  
August 27, 2002

A handwritten signature in cursive script, appearing to read "Mickey Yu".

Mickey Yu  
Supervisory Patent Examiner  
Group 3700

09/771,416

Attorney Docket No. 13493

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Daniel PELLERIN

Serial No.: 09/771,416

Filed: January 26, 2001

For: UNIVERSAL CLEAT

) Group Art Unit: 3728

)

) Examining Attorney: Jila M. Mohandesi

)

) I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING  
) DEPOSITED WITH THE U.S. POSTAL SERVICE AS FIRST CLASS MAIL  
) IN AN ENVELOPE ADDRESSED TO: COMMISSIONER FOR PATENTS,  
) Mail Stop AF, P.O. Box 1450, Alexandria, VA 22313-1450 ON

) 5-16-03

)

  
BY: KIRA LUTCHENKOV

)

)

Pasadena, California

AMENDMENT

Commissioner for Patents  
Mail Stop AF  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:



Please amend the specification as follows:

Please add the following paragraphs at the bottom of page 3.

More specifically, as shown in Figs. 8-11, the manufacturers' shoes have the common characteristic that the bottom (or sole) of each shoe has at least one generally triangularly configured cleat mounting surface with an upstanding border defining a recess for receiving a cleat with a threaded receptacle positioned within the recess for receiving a retaining screw to hold the cleat in place.

One of the shoes provided by a first one of the manufacturers has formed in the bottom exterior surface an equilateral three sided recess formed about the receptacle, sides of the recess extending transversely outwardly from the shoe bottom exterior surface, vertices of the recess being rounded, two of the sides being linear and a third side defining an inset inboard of the line which if drawn would connect two of the vertices in a manner identically to that of the linear sides.

A second shoe provided by a second one of the manufacturers has a generally equilaterally triangular shaped portion extending outwardly respecting the bottom with sides of the triangular raised portion sloping inwardly relative to the triangular shape with increasing distance from the bottom. The vertices of the triangle are rounded. Outer edges of two of the sides are triangular or linear and an outer edge of the third side defines an inset inboard of a line which if drawn would connect two of the vertices identically to that of the linear sides. The triangularly shaped portion is positioned about the threaded receptacle formed in the bottom, with the receptacle substantially midway between the center of the triangular shape and a vertex connecting the two linear edges.

A third shoe furnished by a third one of the manufacturers has a generally isosceles triangular shaped recess formed about the receptacle. Vertices of the recess are rounded and sides of the recess are linear with two equal length sides being substantially the length of the

linear sides of the recess in the first and second shoes. The third side is longer than the equal length sides.

A fourth shoe furnished by a fourth one of the manufacturers has a portion of generally triangular configuration raised transversely from the bottom and surrounding the threaded receptacle adjacently to where one vertex of the triangular configuration would be if two sides of the triangular leading theretowards were extended to intersect. The two sides of the triangular configuration are of equal length and connected by a continuous arc swung about the receptacle. The two equal length sides of the triangular configuration, if extended to intersect, would be defined by vertices, terminating short of intersection and being connected by straight line edges of the portion of generally triangular configuration, to a third side of the triangular configuration. The vertices include an upstanding lip bordering the triangular portion remote from the receptacle with edges of the lip bounding the two equal length sides of the triangular portion, stopping short of intersection.

09/771,416

Attorney Docket No. 13493

Please add claims 10-26 to the application.

1. (original) A universal cleat suitable for use for multiple different baseball shoes, the shoes having a recess in the sole for receiving a cleat, the recess having a threaded opening therein for receiving a retaining screw to hold the cleat in place, the cleat comprising:

- (a) a generally triangular base with a substantially flat bottom for fitting into a plurality of different shaped recesses in different shoes;
- (b) a grip projecting from the base in a plane substantially perpendicular to the plane of the base; and
- (c) an oblong shaped mounting hole in the base for receiving the retaining screw.

2. (original) The cleat of claim 1 wherein the area of the base is smaller than the area of the recesses so that in the absence of the retaining fastener, the cleat can wiggle in the recess.

3. (original) The cleat of claim 1 wherein the ratio of the length of the mounting hole to the width of the mounting hole is from about 8:7 to about 10:7.

4. (original) A baseball shoe comprising:

- (a) a sole;
- (b) multiple recesses in the sole sized for receiving a cleat;
- (c) a threaded opening in each recess;
- (d) a cleat mounted in at least some of the recesses, at least one cleat being a universal cleat comprising (i) a generally triangular base with a substantially flat bottom, (ii) a grip projecting from the base in a plane substantially perpendicular to the plane of the base, and (iii) a mounting hole in the base, at least one of the mounting holes being oblong shaped; and

- (e) a retaining fastener for each cleat extending through the mounting hole and threaded into the respective threaded opening for retaining the respective cleat in place.

5. (previously amended) The shoe of claim 4 wherein the area of the base of each universal cleat is smaller than the area of the respective recess so that in the absence of the retaining fastener, the cleat wiggles in the recess.

6. (original) The shoe of claim 4 wherein the ratio of the length of each oblong shaped mounting hole to the width of the oblong shaped mounting hole is from about 8:7 to about 10:7.

7. (original) The shoe of claim 4 wherein all of the cleats are universal cleats.

8. (original) The cleat of claim 2 wherein the area of the base is from 85 to 95% of the area of the recess.

9. (original) The shoe of claim 5 wherein the area of the base is from 85 to 95% of the area of the recess.

10. (new) A universal cleat usable in any one of a plurality of differently configured athletic shoes furnished by different manufacturers, all of said shoes sharing the common characteristic of the bottom of each shoe of said plurality having at least one generally triangularly configured cleat mounting surface with an upstanding border defining a recess for receiving said cleat with a threaded receptacle positioned within said recess for receiving a retaining screw to hold the cleat in place, with said triangularly configured cleat mounting surfaces all having at least two of the three sides being of equal length, said receptacle being

positioned closer to the vertices of said triangularly configured surfaces which would be defined by intersection of said sides of equal length than to the remaining vertices of said triangularly configured surfaces, said cleat comprising:

(a) A generally triangular planar base adapted for facing contact with said cleat mounting surfaces of said shoes of said plurality, with a longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses in any of said shoes of said plurality;

(b) A grip projecting perpendicularly from the base in a direction oppositely from that of a plane defined by the base planar portion; and

(c) An oblong aperture in the planar portion of said base for passage therethrough of said retaining screw.

11. (new) A universal cleat usable in any one of a plurality of differently configured athletic shoes furnished by different manufacturers, all of said shoes sharing the common characteristic of the bottom of each shoe of said plurality having at least one generally triangularly configured cleat mounting surface with an upstanding border defining a recess for receiving said cleat with a threaded receptacle positioned within said recess for receiving a retaining screw to hold the cleat in place,

(a) a first shoe of said plurality furnished by a first one of said manufacturers having formed in the bottom exterior surface an equilateral three sided recess formed about said receptacle, sides of said recess extending transversely outwardly from said shoe bottom exterior surface, vertices of said recess being rounded, two of said sides being linear and a third side defining an inset inboard of a line which if drawn would connect two of said vertices in a manner identically to that of said linear sides;

(b) a second shoe of said plurality furnished by a second one of said manufacturers having a generally equilaterally triangularly shaped portion extending outwardly respecting said bottom with sides of said triangular raised portions sloping inwardly relative to the

triangular shape with increasing distance from said bottom, with vertices of said triangle being rounded, with outer edges of two of said sides being linear and an outer edge of a third side defining an inset inboard of a line which if drawn would connect two of said vertices in a manner identically to that of said linear sides, with the triangularly shaped portion being positioned about said threaded receptacle formed in said bottom with said receptacle substantially midway between the center of said triangular shape and a vertex connecting said two linear edges;

(c) a third shoe furnished by a third one of said manufacturers having a generally isosceles triangular shaped recess formed about said receptacle with vertices of said recess being rounded and sides of said recess being linear with the two equal length sides being substantially the length of said linear sides of said recesses in said first and second shoes of said plurality as furnished by said first and second manufacturers, said third side being longer than said equal length sides; and

(d) a fourth shoe furnished by a fourth one of said manufacturers having a portion of generally triangular configuration raised transversely from said bottom and surrounding said threaded receptacle adjacently to where one vertex of said triangular configuration would be if two sides of said triangle leading theretowards were extended to intersect, said two sides of said triangular configuration being of equal length and connected by a continuous arc swung about said receptacle, said two equal length sides of said triangular configuration which if extended to intersect would be defined by vertices, terminating short of intersection and being connected by straight line edges of said portion to a third side of said triangular configuration and including an upstanding lip bordering said triangular portion remote from said receptacle with edge portions of said lip bounding said two equal length sides of said triangular portion stopping short of intersection; said cleat comprising:

(i) A generally triangular base with a longest side of said three sides of said base being shorter than the longest side of said triangular recesses in any of said shoes of said plurality;

- (ii) A grip projecting from the base in a plane substantially perpendicular to the plane of the base; and
- (iii) An oblong aperture in the base for passage therethrough of said retaining screw.

12. (new) The cleat of claim 11 wherein said longest side of said three sides of said base is shorter than the shortest of said two equal length sides of said triangular configuration of any of said shoes of said plurality.

13. (new) The cleat of claim 11 wherein the area of said base is smaller than the smallest area of the recess of any of the shoes of said plurality so that in the absence of the retaining fastener, the cleat may wiggle within the recess.

14. (new) The cleat of claim 11 wherein the ratio of length to width of the oblong aperture is from about eight to seven (8:7) to about ten to seven (10:7).

15. (new) A universal cleat usable in any one of a plurality of differently configured baseball shoes furnished by different manufacturers, the bottom of each shoe of said plurality having at least one generally triangularly configured recess with a threaded receptacle positioned within each said recess for receiving a retaining screw to hold the cleat in place, comprising:

- (a) A generally triangular base with a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses in any of said shoes of said plurality;
- (b) A grip projecting from the base in a plane substantially perpendicular to the plane of the base; and
- (c) An oblong aperture in the base for passage therethrough of said retaining screw.



16. (new) The cleat of claim 15 wherein the area of said base is smaller than the smallest area of the recess of any of the shoes of said plurality so that in the absence of the retaining fastener, the cleat may wiggle within the recess.

17. (new) The cleat of claim 15 wherein the ratio of length to width of the oblong aperture is from about eight to seven (8:7) to about ten to seven (10:7).

18. (new) A universal cleat usable in any one of a plurality of differently configured baseball shoes furnished by different manufacturers, the bottom of each shoe of said plurality having a plurality of cleat-receiving recesses, each of said recesses having at least three sides defined by straight lines, with a threaded receptacle positioned within each said recess for receiving a retaining screw to hold the cleat in place, comprising:

(a) A generally triangular base with a longest side being shorter than the longest of any of said straight line sides of said recesses in said shoes of said plurality;

(b) A grip projecting from the base in a plane substantially perpendicular to the plane of the base; and

(c) An oblong aperture in the base for passage therethrough of said retaining screw.

19. A baseball shoe comprising:

(a) A sole;

(b) A plurality of generally triangular recesses formed on said sole for receiving cleats, each recess having at least one generally triangularly configured cleat mounting surface with an upstanding border defining a recess for receiving a cleat, with a threaded receptacle positioned within said recess for receiving a retaining screw to hold the cleat in place, with said triangularly configured cleat mounting surfaces all having at least two of the three sides being of equal length, said receptacle in each recess being positioned closer to the vertices of said triangularly configured surfaces which would be defined by intersection of said sides of

equal length than to the remaining vertices of said triangularly configured surfaces;

(c) Cleats mounted in at least some of said recesses, at least one of said cleats being a universal cleat including:

(i) A generally triangular base with a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses;

(ii) A grip projecting from the base in a plane substantially perpendicular to the plane of the base; and

(iii) An oblong aperture in the base for passage therethrough of said retaining screw.

20. (new) The shoe of claim 19 wherein the area of the base of each universal cleat is less than the area of the respective recess so that in the absence of a retaining screw said universal cleat may wiggle in said recess.

21. (new) The shoe of claim 19 wherein all of said cleats are said universal cleats.

22. (new) The shoe of claim 19 wherein the area of a universal cleat base is from eighty-five percent (85%) to ninety-five percent (95%) of the respective recess.

23. (new) A baseball shoe comprising:

(a) A sole;

(b) A plurality of generally triangular recesses formed on said sole each for receiving a cleat;

(c) A threaded opening in each of said recesses;

(d) Cleats mounted in at least some of said recesses, at least one of said cleats being a universal cleat including:

(i) A generally triangular base with a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses in said sole;

(ii) A grip projecting from the base in a plane substantially perpendicular to the plane of the base; and

(iii) An oblong aperture in the base for passage therethrough of said retaining screw.

24. (new) The shoe of claim 23 wherein the area of the base of each universal cleat is less than the area of the respective recess so that in the absence of a retaining screw said universal cleat may wiggle in said recess.

25. (new) The shoe of claim 23 wherein all of said cleats are said universal cleats.

26. (new) The shoe of claim 23 wherein the area of a universal cleat base is from eighty-five percent (85%) to ninety-five percent (95%) of the respective recess.

REMARKS

Entry of the amendment to the specification and new claims is respectfully requested. They are clearly supported by the specification and drawings as originally submitted. For example, with regard to the amendment to the specification and to claim 11, see Figures 8-11.

The new claims are submitted to further define the invention.

It is believed that applicant's invention is patentable for the reasons previously submitted. Such allowance is respectfully requested.

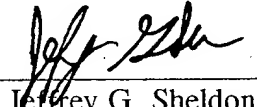
The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 19-2090.

Respectfully submitted,  
SHELDON & MAK

Date:

5/16/2002

By



Jeffrey G. Sheldon  
Reg. No. 27,953

225 South Lake Avenue  
9th Floor  
Pasadena, California 91101  
(626) 796-4000



# Office Action Summary

Application No.

09/771,416

Applicant(s)

PELLERIN, DANIEL

Examiner

Jila M Mohandesi

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-7 and 9 is/are allowed.
- 6) ☒ Claim(s) 1-3, 8 and 10-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

<b>Notice of References Cited</b>	Application/Control No. 09/771,416	Applicant(s)/Patent Under Reexamination PELLERIN, DANIEL	
	Examiner Jila M Mohandesi	Art Unit 3728	Page 1 of 1

#### U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-D454,681	03-2002	Duval, Francois	D2/962
	B	US-3,828,364	08-1974	Aoyama, Yahyo	36/67B
	C	US-3,597,863	08-1971	Austin et al.	36/59R
	D	US-3,029,529	04-1962	Schwartz	36/126
	E	US-1,055,229	03-1913	Rogers	36/64
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

#### FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

#### NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

## DETAILED ACTION

### *Request for Continued Examination*

1. The request filed on 19 May 2003 for a request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 09/771,416 is acceptable and a RCE has been established. An action on the RCE follows.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 10, lines 12-13 and claim 11, lines 40-41, the limitation "with a longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses" and claim 15, lines 6-7, the limitation "with a longest side of said three sides of said base being shorter than the shortest side of any said triangular recesses", and claim 18, lines 6-7, the limitation "with a longest side being shorter than the longest of any of said straight line sides of the recesses, claim 19, lines 13-14, the limitations "a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses" and claim 23, lines 8-9, the limitation "a longest side of said three sides of said base being



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shorter than the shortest side of any of said triangular recesses" are new matter. These limitations are not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3, 8 and 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear whether the applicant intends to claim the combination of a cleat and a baseball shoe or is claiming the subcombination of a cleat for use with the baseball shoe. This is because in many instances claims which appear to be drawn only to the subcombination of the cleat (no baseball shoe has been claimed), are further structurally limited with reference to the baseball shoe. For example only, claim 1, line 1 appears to clearly indicate that no baseball shoe is claimed (the claim is drawn to a cleat for use with a baseball shoe). On the other hand line 2 recites limitation which are dependent on the size of the recess in the baseball shoe. All of the claims should be reviewed for this type of error. With respect to claims such as claims 2, and 16 the claims actually appear to recite that there is a baseball shoe while also appearing (at least from the preamble thereof) to be drawn only to the subcombination of a cleat for use with a baseball shoe. In this office action all references in the claims to the baseball shoe where they are not expressly recited in combination with the claimed cleat is not

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considered to be further structurally limiting with respect to the cleat. The examiner will treat such references to the baseball shoe as merely the applicant's statement of intended use of the cleat in order to give the claims their broadest reasonable interpretation pursuant to PTO practice. On the other hand clarification of the scope of the above noted claims is required in response to this office action.

### ***Specification***

6. The amendment filed May 20, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The phrase "has a generally isosceles and /or equilaterally triangular shape recess formed about the receptacle" is not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Objections***

7. Claim 28 is objected to because of the following informalities: in line 28, "that said" appears to be --than said--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. It is noted that the term "universal cleat" in the preamble has been accorded no weight in the examination in keeping with the courts instructions in *Kropa v. Robie*, 187 F.2d 533, 88 USPQ 478.

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipate by Rogers (1,055,229). Rogers `229 discloses a cleat for a baseball shoe comprising:

- a) a generally triangular base (baseball spike plate 1) with substantially flat bottom;
- b) a grip projecting from the base in a plane substantially perpendicular to the plane of the base (See Figure 1 embodiment);
- c) an oblong shaped mounting hole in the base.

All the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed, "*Ex parte Masham* 2 USPQ2nd 1674. Also *Ex parte Casey* 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has

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all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

The oblong shape mounting hole of Rogers `229 is inherently capable of receiving a retaining screw.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2-3 and 8 are rejected under 35 U.S.C. 103(a) as being obvious over Rogers `229.

With respect to claims 2 and 8, it would have been an obvious matter of design choice to modify the size of the base of the cleat since such a modification would have involved a mere change in the size and shape of a component. A change in size and shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955) and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

With regard to claim 3, the ratio of the length of the mounting hole to the width of the mounting hole would be a design choice depending on the shape and size of the mounting hole.

***Allowable Subject Matter***

13. Claims 4-7 and 9 are allowed.

***Response to Arguments***

14. Applicant's arguments, see arguments, filed march 14, 2003, with respect to the rejection(s) of claim(s) 1-9 under 35 U.S.C. 103(a) as being unpatentable over Tanel (5,058,292) in view of Kawashima et al. (4,590,693) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Rogers `229.

15. The declaration under 37 CFR 1.132 filed 14 March 2003 is insufficient to overcome the rejection of claims 1-9 based upon the rejection of claims 1-9 under 35 U.S.C. 103(a) as being unpatentable over Tanel (5,058,292) in view of Kawashima et al. (4,590,693) as set forth in the last Office action because: The declaration does not set forth facts and does not demonstrate that the commercial success is due to the invention alone.

***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are cleats analogous to applicant's inventions.

5. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical

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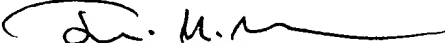
personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the Tech Center 3700 Customer Service Center number is (703) 306-5648. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner cannot confirm receipt of faxes) Please identify Examiner Mohandesi of Art Unit 3728 at the top of your cover sheet of any correspondence submitted. Inquiries only concerning the merits of the examination should be directed to Jila Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.

J. MOHANDESI  
PATENT EXAMINER

  
Jila M Mohandesi  
Examiner  
Art Unit 3728

JMM  
July 25, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent application of:  
Daniel Pellerin

Serial No.: 09/771,416

Filed: January 26, 2001

For: UNIVERSAL CLEAT

Group Art Unit: 3728

Examiner:  
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**RESPONSE TO OFFICE ACTION MAILED JULY 31, 2003**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This paper is being filed in response to the Office Action mailed on July 31, 2003  
("Office Action").

AMENDMENTIn the claims:

Please amend claims 1, 4-7 and 9 as shown below in marked-up form. Claims 2, 3, 8 and 10-26 are shown below in their existing form.

1. (Currently amended) A universal cleat suitable for use ~~for~~ with a plurality of multiple different baseball athletic shoes, the shoes each shoe having a recess in the sole for receiving a cleat, each of the recesses having a threaded opening therein for receiving a retaining screw to hold the cleat in place and each of the recesses having a recess perimeter, the cleat comprising:

- (a) a generally triangular base with a substantially flat bottom, the dimensions of the substantially flat bottom being sized to fit within each recess perimeter; for fitting into a plurality of different shaped recesses in different shoes;
- (b) a grip projecting from the base in a plane substantially perpendicular to the plane of the base; and
- (c) an oblong shaped mounting hole in the base for receiving the retaining screw.

2. (Original) The cleat of claim 1 wherein the area of the base is smaller than the area of the recesses so that in the absence of the retaining fastener, the cleat can wiggle in the recess.

3. (Original) The cleat of claim 1 wherein the ratio of the length of the mounting hole to the width of the mounting hole is from about 8:7 to about 10:7.

4. (Original) A baseball shoe comprising:

- (a) a sole;



- (b) multiple recesses in the sole sized for receiving a cleat;
- (c) a threaded opening in each recess;
- (d) a cleat mounted in at least some of the recesses, at least one cleat being a universal cleat comprising (i) a generally triangular base with a substantially flat bottom, (ii) a grip projecting from the base in a plane substantially perpendicular to the plane of the base, and (iii) a mounting hole in the base, at least one of the mounting holes being oblong shaped; and
- (e) a retaining fastener for each cleat extending through the mounting hole and threaded into the respective threaded opening for retaining the respective cleat in place.

5. (Previously presented) The shoe of claim 4 wherein the area of the base of each universal cleat is smaller than the area of the respective recess so that in the absence of the retaining fastener, the cleat wiggles in the recess.

6. (Original) The shoe of claim 4 wherein the ratio of the length of each oblong shaped mounting hole to the width of the oblong shaped mounting hole is from about 8:7 to about 10:7.

7. (Original) The shoe of claim 4 wherein all of the cleats are universal cleats.

8. (Original) The cleat of claim 2 wherein the area of the base is from 85 to 95 % of the area of the recess.

9. (Original) The shoe of claim 5 wherein the area of the base is from 85 to 95 % of the area of the recess.

10. (Presently presented) A universal cleat usable in any one of a plurality of differently configured athletic shoes furnished by different manufacturers, all of said shoes sharing the common characteristic of the bottom of each shoe of said plurality having at least one generally triangularly configured cleat mounting surface with an

upstanding border defining a recess for receiving said cleat with a threaded receptacle positioned within said recess for receiving a retaining screw to hold the cleat in place, with said triangularly configured cleat mounting surfaces all having at least two of the three sides being of equal length, said receptacle being positioned closer to the vertices of said triangularly configured surfaces which would be defined by intersection of said sides of equal length than to the remaining vertices of said triangularly configured surfaces, said cleat comprising:

- (a) a generally triangular planar base adapted for facing contact with said cleat mounting surfaces of said shoes of said plurality, with a longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses in any of said shoes of said plurality;
- (b) a grip projecting perpendicularly from the base in a direction oppositely from that of a plane defined by the base planar portion; and
- (c) an oblong aperture in the planar portion of said base for passage therethrough of said retaining screw.

11. (Previously presented) A universal cleat usable in any one of a plurality of differently configured athletic shoes furnished by different manufacturers, all of said shoes sharing the common characteristic of the bottom of each shoe of said plurality having at least one generally triangularly configured cleat mounting surface with an upstanding border defining a recess for receiving said cleat with a threaded receptacle positioned within said recess for receiving a retaining screw to hold the cleat in place,

- (a) a first shoe of said plurality furnished by a first one of said manufacturers having formed in the bottom exterior surface an equilateral three sided recess formed about said receptacle, sides of said recess extending transversely outwardly from said shoe bottom exterior surface, vertices of said recess being rounded, two

of said sides being linear and a third side defining an inset inboard of a line which if drawn would connect two of said vertices in a manner identically to that of said linear sides;

- (b) a second shoe of said plurality furnished by a second one of said manufacturers having a generally equilaterally triangularly shaped portion extending outwardly respecting said bottom with sides of said triangular raised portions sloping inwardly relative to the triangular shape with increasing distance from said bottom, with vertices of said triangle being rounded, with outer edges of two of said sides being linear and an outer edge of a third side defining an inset inboard of a line which if drawn would connect two of said vertices in a manner identically to that of said linear sides, with the triangularly shaped portion being positioned about said threaded receptacle formed in said bottom with said receptacle substantially midway between the center of said triangular shape and a vertex connecting said two linear edges;
- (c) a third shoe furnished by a third one of said manufacturers having a generally isosceles triangular shaped recess formed about said receptacle with vertices of said recess being rounded and sides of said recess being linear with the two equal length sides being substantially the length of said linear sides of said recesses in said first and second shoes of said plurality as furnished by said first and second manufacturers, said third side being longer than said equal length sides; and
- (d) a fourth shoe furnished by a fourth one of said manufacturers having a portion of generally triangular configuration raised transversely from said bottom and surrounding said threaded receptacle adjacently to where one vertex of said triangular configuration would be if two sides of said triangle leading

theretowards were extended to intersect, said two sides of said triangular configuration being of equal length and connected by a continuous arc swung about said receptacle, said two equal length sides of said triangular configuration which if extended to intersect would be defined by vertices, terminating short of intersection and being connected by straight line edges of said portion to a third side of said triangular configuration and including an upstanding lip bordering said triangular portion remote from said receptacle with edge portions of said lip bounding said two equal length sides of said triangular portion stopping short of intersection;

said cleat comprising:

- (i) a generally triangular base with a longest side of said three sides of said base being shorter than the longest side of said triangular recesses in any of said shoes of said plurality;
- (ii) a grip projecting from the base in a plane substantially perpendicular to the plane of the base; and
- (iii) an oblong aperture in the base for passage therethrough of said retaining screw.

12. (Previously presented) The cleat of claim 11 wherein said longest side of said three sides of said base is shorter than the shortest of said two equal length sides of said triangular configuration of any of said shoes of said plurality.

13. (Previously presented) The cleat of claim 11 wherein the area of said base is smaller than the smallest area of the recess of any of the shoes of said plurality so that in the absence of the retaining fastener, the cleat may wiggle within the recess.

14. (Previously presented) The cleat of claim 11 wherein the ratio of length to width of the oblong aperture is from about eight to seven (8:7) to about ten to seven (10:7).

15. (Previously presented) A universal cleat usable in any one of a plurality of differently configured baseball shoes furnished by different manufacturers, the bottom of each shoe of said plurality having at least one generally triangularly configured recess with a threaded receptacle positioned within each said recess for receiving a retaining screw to hold the cleat in place, comprising:

- (a) a generally triangular base with a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses in any of said shoes of said plurality;
- (b) a grip projecting from the base in a plane substantially perpendicular to the plane of the base; and
- (c) an oblong aperture in the base for passage therethrough of said retaining screw.

16. (Previously presented) The cleat of claim 15 wherein the area of said base is smaller than the smallest area of the recess of any of the shoes of said plurality so that in the absence of the retaining fastener, the cleat may wiggle within the recess.

17. (Previously presented) The cleat of claim 15 wherein the ratio of length to width of the oblong aperture is from about eight to seven (8:7) to about ten to seven (10:7).

18. (Previously presented) A universal cleat usable in any one of a plurality of differently configured baseball shoes furnished by different manufacturers, the bottom of each shoe of said plurality having a plurality of cleat-receiving recesses, each of said recesses having at least three sides defined by straight lines, with a threaded receptacle positioned within each said recess for receiving a retaining screw to hold the cleat in place, comprising:

- (a) a generally triangular base with a longest side being shorter than the longest of any of said straight line sides of said recesses in said shoes of said plurality;

- (b) a grip projecting from the base in a plane substantially perpendicular to the plane of the base; and
  - (c) an oblong aperture in the base for passage therethrough of said retaining screw.
  
- 19. (Previously presented) A baseball shoe comprising:
  - (a) a sole;
  - (b) a plurality of generally triangular recesses formed on said sole for receiving cleats, each recess having at least one generally triangularly configured cleat mounting surface with an upstanding border defining a recess for receiving a cleat, with a threaded receptacle positioned within said recess for receiving a retaining screw to hold the cleat in place, with said triangularly configured cleat mounting surfaces all having at least two of the three sides being of equal length, said receptacle in each recess being positioned closer to the vertices of said triangularly configured surfaces which would be defined by intersection of said sides of equal length than to the remaining vertices of said triangularly configured surfaces;
  - (c) cleats mounted in at least some of said recesses, at least one of said cleats being a universal cleat including:
    - (i) a generally triangular base with a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses;
    - (ii) a grip projecting from the base in a plane substantially perpendicular to the plane of the base; and,
    - (iii) an oblong aperture in the base for passage therethrough of said retaining screw.

20. (Previously presented) The shoe of claim 19 wherein the area of the base of each universal cleat is less than the area of the respective recess so that in the absence of a retaining screw said universal cleat may wiggle in said recess.

21. (Previously presented) The shoe of claim 19 wherein all of said cleats are said universal cleats.

22. (Previously presented) The shoe of claim 19 wherein the area of a universal cleat base is from eighty-five percent (85 %) to ninety-five percent (95 %) of the respective recess.

23. (Previously presented) A baseball shoe comprising:

- (a) a sole;
- (b) a plurality of generally triangular recesses formed on said sole each for receiving a cleat;
- (c) a threaded opening in each of said recesses;
- (d) cleats mounted in at least some of said recesses, at least one of said cleats being a universal cleat including:
  - (i) a generally triangular base with a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses in said sole;
  - (ii) a grip projecting from the base in a plane substantially perpendicular to the plane of the base; and
  - (iii) an oblong aperture in the base for passage therethrough of said retaining screw.

24. (Previously presented) The shoe of claim 23 wherein the area of the base of each universal cleat is less than the area of the respective recess so that in the absence of a retaining screw said universal cleat may wiggle in said recess.

25. (Previously presented) The shoe of claim 23 wherein all of said cleats are said universal cleats.

26. (Previously presented) The shoe of claim 23 wherein the area of a universal cleat base is from eighty-five percent (85 %) to ninety-five percent (95 %) of the respective recess.



**REMARKS**

This paper is filed in response to the Office Action. Claims 4-7 and 9 are allowed, and claims 1-3, 8 and 10-26 are rejected. Applicant herein amends independent claim 1.

**Rejections under 35 U.S.C. § 112 ¶ 1**

At pages 2-3 of the Office Action, Examiner states that claims 10-26 are rejected under 35 U.S.C. § 112 ¶ 1 as failing to comply with the written description requirement. Specifically, Examiner states that independent claims 10, 11, 15, 18, 19 and 25 contain features that are not supported by the specification (hereinafter the "Features"). Applicant respectfully traverses this rejection at least for the reasons discussed below.

Applicant respectfully submits that the Features are supported by the original specification in such a way as to reasonably convey to one skilled in the art that the inventor was in possession of the claimed invention at the time the application was filed. Specifically, the Features of claims 10, 11, 15, 18, 19 and 25 are clearly shown in the drawings originally filed as part of the specification.

Certain amendments to a specification do not constitute new matter. For example, an amendment is not considered new matter when it simply makes a disclosure of information that one in skilled in the art would have already have understood to be disclosed in the application as originally filed. See generally M.P.E.P. § 2163.07. As another example, rewording and rephrasing of previously disclosed subject matter does not constitute new matter. See, e.g., In re Anderson, 471 F.2d 1237, 1244 (C.C.P.A. 1973).

“[T]o avoid the new matter prohibition, an applicant must show that its original application supports the amended matter.” Schering Corp. v. Amgen, Inc., 222 F.3d 1347, 1352 (Fed. Cir. 2000). “The fundamental inquiry is whether the material added by the amendment was inherently contained in the original application.” Id. Applicant submits that the Features are disclosed by the originally filed drawings.

Applicant respectfully refers Examiner to the case of In re Reynolds, 443 F.2d 384 (C.C.P.A. 1971). In Reynolds, the patent application as originally filed contained a drawing that the Court held taught the features of later-added claims, even though the original specification did not contain text teaching the feature. See generally In re Reynolds, 443 F.2d 384 (C.C.P.A. 1971). In Reynolds, the applicant argued that the drawings disclosed the subject-matter of the later added claims; **the examiner agreed in general with the applicant that the drawing can be used as disclosure in supporting claims** but, contended that the particular drawings in Reynolds’ application did not disclose a certain geometry which was in question and that Reynolds’ position on the issue of presence of the disclosure in question in the drawing was “merely conjecture.”

The Court opined on this issue as follows:

First, we do not think [applicant’s] position is ‘mere conjecture’ in view of what is apparently a geometric certainty in Fig. 2. **We realize that a patent drawing does not have to be to any particular scale. Nevertheless, a person attempting to construct a capacitor following appellant’s disclosure would have to distort significantly the relationships shown in Fig. 2 in order not to produce a device which would inherently perform the recited function. In view of the unusual shape of plate 24 and the eccentric mounting of plate 26 on shaft 17, we think a person skilled in the art would suspect that there was some reason for the relationships shown in the drawing and would not regard such disclosure as accidental or arbitrary.**

Id. at 389 (emphasis added) (cited by M.P.E.P. § 2163.07(a) for the additional

proposition that a disclosure of a device in the original application can support a later amendment of a function, use or advantage of that device). A marked-up photocopy of the Reynolds decision is attached for the convenience of the Examiner.

Applicant respectfully submits that the Features cited by Examiner from independent claims 10, 11, 15, 18, 19 and 25 are supported by the originally filed drawings. Generally, the Features relate to the size of the longest side of the base relative to the longest side of the triangular recess. The Features are disclosed at least in Figures 8-11, where it is shown that the base of the inventive cleat fits within the triangular recesses of the prior art. In order for the base of the cleat to fit within the triangular recess in the manner shown by the drawing, it is an inherent geometric necessity that the longest side of the base is shorter than the longest side of the triangular recess.

Regarding dependent claims 12-14, 16, 17 and 20-24, Examiner has not expressly stated which aspect of the claim is the basis of the rejection. Applicant thus believes Examiner has rejected these claims due to the Examiner's concern's regarding the independent claims. Applicant thus respectfully traverses the rejection of dependent claims 12-14, 16, 17 and 20-24 at least for the same reasons as Applicant's traversal of independent claims 10, 11, 15, 18, 19 and 25

For at least these reasons, Applicant respectfully requests that Examiner withdraw the rejection under 35 U.S.C. § 112 ¶ 1 and immediately allow pending claims 10-26.

**Rejections under 35 U.S.C. § 112 ¶ 2**

At pages 3-4 of the Office Action, Examiner states that claims 1-3, 8 and 10-18 are rejected under 35 U.S.C. § 112 ¶ 2 as failing to particularly point out and identify the

subject matter. Examiner states that there is confusion as to whether Applicant is claiming the cleat or is claiming the cleat in combination with the shoe. The Examiner further indicates that Examiner will treat the claims as if the reference to the shoe is merely a statement of intended use and requested clarification.

For the record, Applicant clarifies that the scope of the claims as follows: Claims 1-3 and 10 through 18 are directed to the cleat. Claims 4 through 9 and 19 through 26 are directed to a shoe having the inventive cleat. Applicant thus respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 112 ¶ 2 and immediately allow claims 1-3, 8 and 10-18.

**Rejections under 35 U.S.C. § 132**

At page 4 of the Office Action, Examiner states that the amendment of May 30, 2003, is objected to under 35 U.S.C. § 132 as adding new matter with regards to the phrase “has a generally isosceles and/or equilaterally triangular shape recess formed about the receptacle.”

Applicant respectfully traverses this rejection at least for the following reasons. The text of the May 30, 2003, amendment characterizes the four manufacturer's shoes. The shoes themselves are prior art and this passage is characterizing the prior art. There is a presumption that all those skilled in the art would have all knowledge of the prior art upon reading the patent application and, thus no new matter has been added to the application. For at least these reasons, Applicant respectfully requests that Examiner withdraw the objection under 35 U.S.C. § 132 and allow the amendment.

**Rejections under 35 U.S.C. § 102(a)**

At pages 4-6 of the Office Action, Examiner states that claim 1 is rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 1,055,229 ("Roger"). Applicant has herein amended claim 1 thereby mooting the rejection. Applicant believes that amended claim 1 is patentable and respectfully requests that Examiner allow amended claim 1.

**Rejections under 35 U.S.C. § 103(a)**

At page 6 of the Office Action, Examiner states that claims 2, 3, and 8 are rejected under 35 U.S.C. § 103(a) as being obvious over Rogers. Applicant amended base claim 1 thereby mooting this rejection. Applicant believes amended claim 1 is patentable and that the dependent claims are thus patentable at least by virtue of their dependency from a patentable claim. For at least this reason, Applicant respectfully requests that Examiner allow dependent claims 2, 3 and 8.

Applicant reserves the right to later argue in this and/or another proceeding that dependent claims 2, 3 and/or 8 are patentable on additional and/or alternative grounds.

**CONCLUSION**

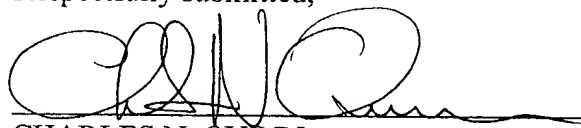
Applicant believes that Applicant has fully responded to the Examiner's concerns and that all of the claims are in condition for immediate allowance. Applicant respectfully requests immediate allowance of all claims.

To the extent there is any fee required in connection with the receipt, acceptance and/or consideration of this paper and/or any accompanying papers submitted herewith, please charge all such fees to Deposit Account 50-1943.

Applicant requests that any questions concerning this matter be directed to the undersigned at (215) 299-2135.

Respectfully submitted,

Date: 2 FEBRUARY 2004



CHARLES N. QUINN

Registration No. 27,223

Attorney for Assignee

Fox Rothschild, LLP

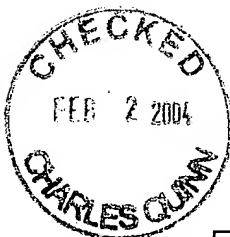
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**CERTIFICATE OF MAILING  
UNDER 37 C.F.R. 1.8(a)**

I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date indicated below, with sufficient postage, as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Michi Lockner  
(signature)

BY: Michi Lockner

DATE: February 2, 2004



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/771,416

01/26/2001

Daniel Pellerin

13493-81699.5001

6341

34661

7590

07/13/2004

CHARLES N. QUINN

FOX, ROTHCHILD, O'BRIEN & FRANKEL, LLP  
2000 MARKET STREET, 10TH FLOOR  
PHILADELPHIA, PA 19103

EXAMINER

MOHANDESI, JILA M

ART UNIT

PAPER NUMBER

3728

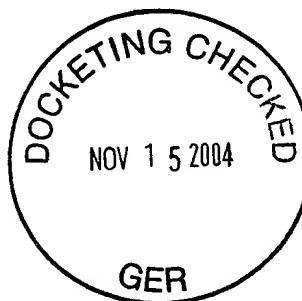
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JUL 19 2004

DATE MAILED: 07/13/2004

FOX ROTHSCHILD LLP

Please find below and/or attached an Office communication concerning this application or proceeding.



DOCKETED

NOV 15 2004

SHERY BARAG



**Office Action Summary**

Application No.

09/771,416

Applicant(s)

PELLERIN, DANIEL

Examiner

Jila M Mohandesi

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-7 and 9 is/are allowed.
- 6) ☒ Claim(s) 1-3, 8 and 10-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 03-24-2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.



## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 10, lines 12-13 and claim 11, lines 40-41, the limitation "with a longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses" and claim 15, lines 6-7, the limitation "with a longest side of said three sides of said base being shorter than the shortest side of any said triangular recesses" , and claim 18, lines 6-7, the limitation "with a longest side being shorter than the longest of any of said straight line sides of the recesses, claim 19, lines 13-14, the limitations "a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses" and claim 23, lines 8-9, the limitation "a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses" are new matter. These limitations are not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

***Specification***

3. The amendment filed May 20, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The phrase "has a generally isosceles and /or equilaterally triangular shape recess formed about the receptacle" is not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. It is noted that the term "universal cleat" in the preamble has been accorded no weight in the examination in keeping with the courts instructions in *Kropa v. Robie*, 187 F.2d 533, 88 USPQ 478.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipate by Rogers (1,055,229). Rogers `229 discloses a cleat for a baseball shoe comprising:

a) a generally triangular base (baseball spike plate 1) with substantially flat bottom;

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- b) a grip projecting from the base in a plane substantially perpendicular to the plane of the base (See Figure 1 embodiment);
- c) an oblong shaped mounting hole in the base.

All the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed," *Ex parte Masham* 2 USPQ2d 1674. Also *Ex parte Casey* 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

The oblong shape mounting hole of Rogers '229 is inherently capable of receiving a retaining screw.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3728

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-3 and 8 are rejected under 35 U.S.C. 103(a) as being obvious over Rogers `229.

With respect to claims 2 and 8, it would have been an obvious matter of design choice to modify the size of the base of the cleat since such a modification would have involved a mere change in the size and shape of a component. A change in size and shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955) and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

With regard to claim 3, the ratio of the length of the mounting hole to the width of the mounting hole would be a design choice depending on the shape and size of the mounting hole.

#### ***Allowable Subject Matter***

9. Claims 4-7 and 9 are allowed.

#### ***Response to Arguments***

10. Applicant's arguments filed February 4, 2004 have been fully considered but they are not persuasive. Contrary to applicant's argument, examiner contends that the drawings do not disclose the subject-matter of the later added claims. Geometry certainty of the questionable limitations is not present in the original drawings as filed.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JILA M. MOHANDESI  
PRIMARY EXAMINER**



Jila M Mohandesi  
Primary Examiner  
Art Unit 3728

JMM  
July 09-2004

MAR 24 2004

Sheet 1 of 1

**Form PTO-1449 Modified**

Client Matter No.  
81699.15001

Serial No.  
09/771,416

List of Patent and Publications Cited by Applicant  
(Use several sheets if necessary)

Applicant  
Daniel Pellerin

U.S. Department of Commerce  
Patent and Trademark Office

Filing Date  
1/26/2001

Group  
3728

**U. S. PATENT DOCUMENTS**

Examiner Initial		Document No.	Date	Name	Class	Subclass
<i>jm</i>	AA	D341,479	11/1993	Saito et al.	D2	314
<i>j</i>	AB	D405,249	2/1999	Hikita et al.	D2	962
<i>jm</i>	AC	D454,681	2/2002	Duval	D2	962

**FOREIGN PATENT DOCUMENTS**

Examiner Initial		Document No.	Date	Country	Translation YES NO

**OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)**

		<b>RECEIVED</b>
		MAR 31 2004
		TECHNOLOGY CENTER R3700
EXAMINER	<i>J. M. M.</i>	DATE CONSIDERED 07-09-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent application of:  
Daniel Pellerin

Serial No.: 09/771,416

Filed: January 26, 2001

For: UNIVERSAL CLEAT

Group Art Unit: 3728

Examiner:  
Jila M. Mohandesi

Charles N. Quinn  
Reg. No. 27,223  
Fox Rothschild LLP  
2000 Market Street, 10<sup>th</sup> Floor  
Philadelphia, PA 19103  
Tel: 215-299-2135  
Fax: 215-299-2150  
Email: [cquinn@foxrothschild.com](mailto:cquinn@foxrothschild.com)  
Deposit Account: 50-1943

**RESPONSE TO OFFICE ACTION MAILED JULY 13, 2004**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**Introductory Comments**

This paper is being filed in response to the Office Action mailed on July 13, 2004 ("Office Action"). Applicant herein cancels rejected claims 1-3, 8, and 10-26 without prejudice. Applicant respectfully requests that the Examiner expedite issuance of allowed claims 4-7 and 9.



**Amendments to the Specification**

Please amend the following paragraphs that were previously added to the bottom of page 3 by Applicant's amendment filed May 20, 2003:

More specifically, as shown in Figs. 8-11, the manufacturers' shoes 12 have the common characteristic that the ~~bottom (or sole)~~ sole of each shoe 12 has at least one generally triangularly configured cleat mounting surface with ~~an upstanding~~ a border defining a generally triangular recess 14 for receiving a cleat 10 with a threaded receptacle 18 positioned within ~~the~~ the generally triangular recess 14 for receiving a retaining screw to hold ~~the~~ the cleat 10 in place.

As principally shown in Figure 8, a first shoe 12a, One of the shoes provided by a first one of the manufacturers, has formed the bottom exterior surface an equilateral three-sided includes a generally triangular recess 14a formed in the sole around about the threaded receptacle 18, sides of the generally triangular recess 14a extending transversely outwardly from the sole shoe bottom exterior surface, with vertices of the generally triangular recess 14a being rounded, two of the sides being straight linear and a third side having defining an inset inboard of the a line which, if drawn, would connect two of the vertices in a the same manner as identically to that of the straight linear sides.

As shown in Figure 9, a A second shoe 12b, provided by a second one of the manufacturers, has a generally equilaterally triangular shaped raised portion extending outwardly respecting the sole, bottom with sides of the triangularly shaped raised portion sloping inwardly relative to the triangularly shaped raised portion with increasing distance from the sole bottom. The vertices of the triangle generally triangular recess 14b are rounded. Outer edges of two Two of the sides of generally triangular recess 14b are straight triangular or linear and a third side defines has an inset inboard of a line which, if drawn, would connect two of the vertices in the same manner as identically to that of the straight linear sides. The triangularly shaped raised portion is positioned around about the threaded receptacle 18 formed in the sole bottom, with the threaded receptacle 18 substantially midway between the center of the triangularly shaped raised portion and a vertex connecting the two straight sides linear edges.

A third shoe furnished by a third one of the manufacturers has a generally isosceles triangular shaped recess formed about the

~~receptacle. Vertices of the recess are rounded and sides of the recess are linear with two equal length sides being substantially the length of the linear sides of the recess in the first and second shoes. The third side is longer than the equal length sides.~~

As shown in Figure 10, a third shoe 12c provided furnished by a third one of the manufacturers, has a portion of generally triangular rib configuration extending raised transversely from the sole bottom and surrounding the threaded receptacle 18. adjacently to Generally triangular rib is open, the two ends of generally triangular rib stopping short of where one vertex of the generally triangular rib configuration would be if the two sides of the generally triangular rib leading theretowards were extended to intersect. The two sides of the generally triangular rib configuration are of equal length and are connected by a third side having a continuous arc is swung from the top of the third side in a plane parallel to the third side and perpendicular to the sole, about the receptacle. The two equal length sides of the triangular configuration, if extended to intersect, would be defined by vertices, terminating short of intersection and being connected by straight line edges of the portion of generally triangular configuration, to a third side of the triangular configuration. The generally triangular rib includes an upstanding lips extending inwardly toward the center of the triangle and parallel with the sole from the tops of each of the two equal length sides, bordering the triangular portion remote from the receptacle with edges of the lips bounding bordering the two equal length sides of the triangular portion, and stopping short of intersection vertices of said triangular rib.

As shown in Figure 11, a fourth shoe 12d, provided by a fourth one of the manufacturers, has a generally triangular recess 14d formed about threaded receptacle 18. Vertices of generally triangular recess 14d are rounded and sides of the recess are straight with two equal length sides being substantially the length of the straight sides of generally triangular recess 14b of second shoes 12b. The third side is longer than the equal length sides. The third side is straight.

**Amendments to the Claims**

Please cancel claims 1-3, 8, and 10-26 as shown below:

1. (Cancelled)
2. (Cancelled)
3. (Cancelled)
4. (Original) A baseball shoe comprising:
  - (a) a sole;
  - (b) multiple recesses in the sole sized for receiving a cleat;
  - (c) a threaded opening in each recess;
  - (d) a cleat mounted in at least some of the recesses, at least one cleat being a universal cleat comprising (i) a generally triangular base with a substantially flat bottom, (ii) a grip projecting from the base in a plane substantially perpendicular to the plane of the base, and (iii) a mounting hole in the base, at least one of the mounting holes being oblong shaped; and
  - (e) a retaining fastener for each cleat extending through the mounting hole and threaded into the respective threaded opening for retaining the respective cleat in place.
5. (Previously presented) The shoe of claim 4 wherein the area of the base of each universal cleat is smaller than the area of the respective recess so that in the absence of the retaining fastener, the cleat wiggles in the recess.

6. (Original) The shoe of claim 4 wherein the ratio of the length of each oblong shaped mounting hole to the width of the oblong shaped mounting hole is from about 8:7 to about 10:7.

7. (Original) The shoe of claim 4 wherein all of the cleats are universal cleats.

8. (Cancelled)

9. (Original) The shoe of claim 5 wherein the area of the base is from 85 to 95 % of the area of the recess.

10. (Cancelled)

11. (Cancelled)

12. (Cancelled)

13. (Cancelled)

14. (Cancelled)

15. (Cancelled)

16. (Cancelled)

17. (Cancelled)

18. (Cancelled)

19. (Cancelled)

20. (Cancelled)

21. (Cancelled)

22. (Cancelled)

23. (Cancelled)

24. (Cancelled)

25. (Cancelled)

26. (Cancelled)

**REMARKS**

This paper is filed in response to the Office Action mailed July 13, 2004. Claims 4-7 and 9 are allowed, and claims 1-3, 8, and 10-26 are cancelled.

**Allowable Claims 4-7 and 9**

Claims 4-7 and 9 are allowable. Applicant respectfully requests that the Examiner have claims 4-7 and 9 expeditiously proceed to issuance.

**Rejection of Claims 1-3, 8, and 10-26**

Applicant respectfully traverses all rejections of claims 1-3, 8, and 10-26. However, without prejudice, Applicant herein cancels claims 1-3, 8, and 10-26 in order to expedite prosecution of claims 4-7 and 9. Applicant does not cancel any of claims 1-3, 8, and 10-26 for reasons relating to patentability, but desires to avoid any delay in the issuance of allowed claims 4-7 and 9.

Applicant respectfully reserves the right to pursue and argue the patentability of claims 1-3, 8, and/or 10-26 in one or more additional patent applications. Applicant does not surrender any subject matter.

**Rejection to the Specification Under 35 U.S.C. § 132**

At page 3 of the Office Action, the Examiner requests that Applicant cancel text added to the specification that characterizes the recesses as "equilateral" or "isosceles." Applicant respectfully disagrees with the rejection and requests reconsideration of the

rejection. However, without prejudice, Applicant cancels the additional text in order to expedite prosecution of allowed claims 4-7 and 9.

Applicant reserves the right (i) to include the additional text as part of the specification of a continuation application, (ii) to claim priority in the continuation application to the present application to obtain the benefit of the filing date of the present application, and (iii) to present argument in the continuation application that the additional text does not constitute new matter.

**Additional Amendment to the Specification**

Applicant requests additional minor amendment to the passage added May 20, 2003. The Examiner will note that the requested amendment to the specification is for two purposes: (1) to enhance the internal consistency of the vocabulary used in the passage; and (2) to enhance the clarity of the passage. Applicant respectfully submits that the requested amendment to the specification does not constitute new matter and requests that the Examiner allow this portion of the amendment to the specification.

**Date of the Amendment of May 2003**

Applicant observes that there is a discrepancy in the filing date of the Amendment of May 2003, noting multiple dates in the record and on PAIR. Applicant believes the correct date for the amendment is May 16, 2003. Applicant respectfully requests that the Examiner clarify this issue for the record.

**Conclusion**


Applicant believes that Applicant has fully responded to the Examiner's concerns and that all of the pending claims are in condition for immediate issuance. Applicant respectfully requests immediate issuance of all pending claims.

To the extent there is any fee required in connection with the receipt, acceptance and/or consideration of this paper and/or any accompanying papers submitted herewith, please charge all such fees to Deposit Account 50-1943.

Applicant requests that any questions concerning this matter be directed to the undersigned at (215) 299-2135.

Respectfully submitted,

Date: 15 November 2004



CHARLES N. QUINN  
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Attorney for Assignee  
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2000 Market Street, 10<sup>th</sup> Floor  
Philadelphia, PA 19103  
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email: cquinn@foxrothschild.com



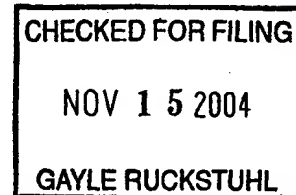
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UNDER 37 C.F.R. 1.8(a)**

I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date indicated below, with sufficient postage, as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
(signature)

BY: Gayle Ruckstuhl

DATE: 15 November 2004





UNITED STATES PATENT AND TRADEMARK OFFICE

81699.15001

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United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,416	01/26/2001	Daniel Pellerin	13493	6341

34661 7590 02/02/2005

CHARLES N. QUINN  
FOX ROTHSCHILD LLP  
2000 MARKET STREET, 10TH FLOOR  
PHILADELPHIA, PA 19103

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EXAMINER

MOHANDESI, JILA M

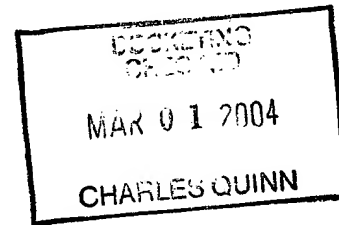
ART UNIT PAPER NUMBER

3728

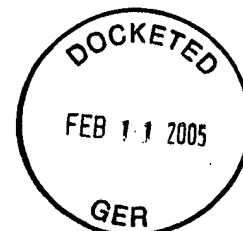
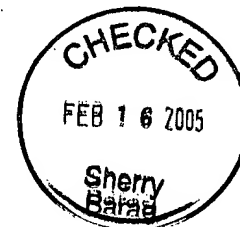
DATE MAILED: 02/02/2005

FOX ROTHSCHILD LLP

Please find below and/or attached an Office communication concerning this application or proceeding.

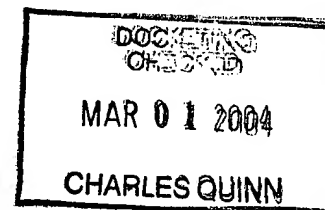


RESPONSE FILED:  
Date 8/2/05 By RD  
DOCKETING SATISFIED:  
Date 8/3/05 By AB  
IP GROUP  
FOX ROTHSCHILD LLP



FEB 8 2005

Q



<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/771,416	PELLERIN, DANIEL	
	Examiner	Art Unit	
	Jila M Mohandesi	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Upon further review and consideration of the claims, the finality of the rejection of the last Office action mailed July 13, 2004 is withdrawn. The after final amendment filed November 17, 2004 has not been entered.
2. The indicated allowability of claims 4-7 and 9 is withdrawn in view of the newly discovered reference(s) to Ueda et al. (5,943,795) and Dassler (4,523,396). Rejections based on the newly cited reference(s) follow.

#### ***Request for Continued Examination***

3. The request filed on 19 May 2003 for a request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 09/771,416 is acceptable and a RCE has been established. An action on the RCE follows.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:  

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 10-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 10, lines 12-13 and claim 11, lines 40-41, the limitation "with a longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses" and claim 15, lines 6-7, the

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limitation "with a longest side of said three sides of said base being shorter than the shortest side of any said triangular recesses" , and claim 18, lines 6-7, the limitation "with a longest side being shorter than the longest of any of said straight line sides of the recesses, claim 19, lines 13-14, the limitations "a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses" and claim 23, lines 8-9, the limitation "a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses" are new matter. These limitations are not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-3, 8 and 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear whether the applicant intends to claim the combination of a cleat and a baseball shoe or is claiming the subcombination of a cleat for use with the baseball shoe. This is because in many instances claims which appear to be drawn only to the subcombination of the cleat (no baseball shoe has been claimed), are further structurally limited with reference to the baseball shoe. For example only, claim 1, line 1 appears to clearly indicate that no baseball shoe is claimed (the claim is drawn to a cleat for use with a baseball shoe). On the other hand line 2 recites limitation which are

dependent on the size of the recess in the baseball shoe. All of the claims should be reviewed for this type of error. With respect to claims such as claims 2, and 16 the claims actually appear to recite that there is a baseball shoe while also appearing (at least from the preamble thereof) to be drawn only to the subcombination of a cleat for use with a baseball shoe. In this office action all references in the claims to the baseball shoe where they are not expressly recited in combination with the claimed cleat is not considered to be further structurally limiting with respect to the cleat. The examiner will treat such references to the baseball shoe as merely the applicant's statement of intended use of the cleat in order to give the claims their broadest reasonable interpretation pursuant to PTO practice. On the other hand clarification of the scope of the above noted claims is required in response to this office action.

#### ***Specification***

8. The amendment filed May 20, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The phrase "has a generally isosceles and /or equilaterally triangular shape recess formed about the receptacle" is not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

#### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. It is noted that the term “universal cleat” in the preamble has been accorded no weight in the examination in keeping with the courts instructions in *Kropa v. Robie*, 187 F.2d 533, 88 USPQ 478.

11. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipate by Rogers (1,055,229). Rogers '229 discloses a cleat for a baseball shoe comprising:

- a) a generally triangular base (baseball spike plate 1) with substantially flat bottom;
- b) a grip projecting from the base in a plane substantially perpendicular to the plane of the base (See Figure 1 embodiment);
- c) an oblong shaped mounting hole in the base.

All the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that “recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed, “*Ex parte Masham* 2 USPQ2nd 1674. Also *Ex parte Casey* 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims “read on” something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983).

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Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

The oblong shape mounting hole of Rogers `229 is inherently capable of receiving a retaining screw.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2-3 and 8 are rejected under 35 U.S.C. 103(a) as being obvious over Rogers `229.

With respect to claims 2 and 8, it would have been an obvious matter of design choice to modify the size of the base of the cleat since such a modification would have involved a mere change in the size and shape of a component. A change in size and shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955) and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).



With regard to claim 3, the ratio of the length of the mounting hole to the width of the mounting hole would be a design choice depending on the shape and size of the mounting hole.

14. Claims 1, 3-4, 6-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanel (5,058,292) in view of Kawashima et al. (4,590,693) and Ueda et al. (5,943,795). Tanel '292 discloses an universal cleat suitable for use for multiple different baseball shoes, the shoes having a recess in the sole (column 8, lines 63-66) for receiving a cleat, the cleat comprising a generally triangular base (11) with a substantially flat bottom for fitting into a plurality of different shaped recesses in different shoes (column 9, lines 1-3); a grip (13) projecting from the base in a plane substantially perpendicular to the plane of the base; and a mounting hole (29) in the base, the mounting hole can have any convenient shape (column 7, line 6-8). Tanel '292 does not appear to have a threaded opening in the recess for receiving a retaining screw to hold the cleat in place and for the mounting hole to be oblong shaped. Kawashima '693 discloses a baseball shoe having a recess (5) with threaded opening (4) therein for receiving a retaining screw (9) to hold a cleat (8) in place and allow for easier replacement of the cleat. Ueda '795 discloses that it is desirable to have the mounting hole oblong shape for connecting the cleat to the sole to allow more adjustability. See Figure 7 embodiment. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a threaded opening in the recess of Tanel '292 for receiving a retaining screw as taught by Kawashima '693 to better secure the cleat to the sole. Also, it would have been obvious to one of ordinary skill in

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the art at the time the invention was made to make the mounting hole of Tanel '292 oblong shaped as taught by Ueda '795 to allow more adjustability.

With regard to claims 3 and 6, the ratio of the length of the mounting hole to the width of the mounting hole as modified appears to be 8:7 to about 10:7.

15. Claims 2, 5 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claims 1 and 4 above, and further in view of Dassler (4,523,396). Tanel '292 as modified above discloses all the limitations of the claims except for the specific area of the base with respect to the area of the recess. Dassler '396 discloses a shoe with a sole having a plurality of recesses for receiving a cleat. Dassler '396 discloses that depending on the shape of the base of the cleat there is no need for the fit between the inside wall of the openings/recesses (4) and the circumference of the base parts (5) to be too close therefore allowing the cleat to wiggle in the recess in the absence of the retaining fastener. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to Make the area of the base of the cleat smaller than the area of the recess as taught by Dassler 396 for easier interchangeability of the cleats.

With regard to claims 8 and 9, it appears that the area of the base is from 85 to 95% of the area of the recess, furthermore, the relationship between the area of the base and the area of the recess will depend on the type and shape of cleat being used.

### ***Response to Arguments***

16. The declaration under 37 CFR 1.132 filed 14 March 2003 is insufficient to overcome the rejection of claims 1-9 based upon the rejection of claims 1-9 under 35

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U.S.C. 103(a) as being unpatentable over Tanel (5,058,292) in view of Kawashima et al. (4,590,693) as set forth in the last Office action because: The declaration does not set forth facts and does not demonstrate that the commercial success is due to the invention alone.

**Conclusion**

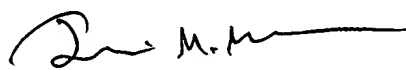
17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are cleats analogous to applicant's inventions.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JILA M. MOHANDESI  
PRIMARY EXAMINER**



Jila M Mohandesi  
Primary Examiner  
Art Unit 3728

Application/Control Number: 09/771,416  
Art Unit: 3728

Page 10

JMM  
February 01, 2005

**Notice of References Cited**

Application/Control No.

09/771,416

Applicant(s)/Patent Under  
Reexamination  
PELLERIN, DANIEL

Examiner

Jila M Mohandesi

Art Unit

3728

Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,943,795	08-1999	Ueda et al.	36/131
	B	US-5,058,292	10-1991	Tanel, Michael L.	36/126
	C	US-4,590,693	05-1986	Kawashima et al.	36/126
	D	US-4,523,396	06-1985	Dassler, Armin A.	36/134
	E	US-3,816,946	06-1974	Davis et al.	36/67D
	F	US-3,812,605	05-1974	Kaestle, Berthold	36/67D
	G	US-3,526,976	09-1970	JACOBS CHARLES E	36/100
	H	US-3,442,033	05-1969	HILBURN GLENN E JR	36/114
	I	US-1,055,229	03-1913	Rogers	36/64
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Daniel Pellerin

Serial No.: 09/771,416

Filed: January 26, 2001

For: UNIVERSAL CLEAT

Group Art Unit: 3728

Examiner:  
Jila M. Mohandesi

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**RESPONSE TO OFFICE ACTION**

Mail Stop Amendments  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**Introductory Comments**

This paper responds to the Office Action mailed on February 2, 2005.

Applicant respectfully submits that the examiner has misapplied existing law in rejecting the instant application. Applicant has endeavored in the remarks section of this response and in the amendments to the claims, to disabuse the examiner of those erroneous impressions and understandings regarding existing law in an endeavor to place this application into form for allowance.

In light of the foregoing, applicant traverses the rejection of claims 10 through 26 made under 35 USC 112, first paragraph as allegedly failing to comply with the written description requirement and requests reconsideration thereof.

Applicant further traverses the rejection of claims 1 through 3, 8 and 10 through 18 made under 35 USC 112, second paragraph, as allegedly being insufficiently definite and failing to particularly point out describe, and claim the subject matter which applicant regards as the invention, and requests reconsideration thereof.

Applicant still further traverses the rejection of claim 1 made under 35 USC 102(b) as allegedly being anticipated by U.S. patent 1,055,229 to Rogers and requests reconsideration of that rejection.

Applicant further traverses the rejection of claims 2, 3 and 8 made under 35 USC 103 as allegedly being obvious in light of U.S. patent 1,055,229 to Rogers and requests reconsideration of the rejection.

Applicant further traverses the rejection made of claims 1, 3, 4, 6, 7 and 9 under 35 USC 103 as allegedly being obvious to one of ordinary skill in the art and therefore unpatentable when considering U.S. patent 5,058,292 to Tanel in view of U.S. patent 4,590,693 to Kawashima, et al. and U.S. patent 5,943,795 to Ueda, et al. Reconsideration of this rejection is also respectfully requested.

Applicant further traverses the rejection of claims 2, 5, 8 and 9 made under 35 USC 103 on the basis of U.S. patent 5,058,292 to Tanel in view of U.S. patent 4,590,693 to Kawashima, et al. and further in view of U.S. patent 4,523,396 to Dassler and requests reconsideration.

## AMENDMENT TO THE CLAIMS

Please amend the claims as shown below:

1. (Currently Amended) A universal cleat suitable for use with a plurality of different athletic shoes, each different shoe having a uniquely shaped generally triangular recesses in the sole each for receiving a cleat, each ~~of the recesses~~ recess having a threaded opening therein for receiving a retaining screw to hold ~~the~~ a cleat in place and each ~~of the recesses~~ recess having a recess perimeter, the cleat comprising:
  - (a) a one piece molded plastic generally triangular base having two straight sides of equal length with a substantially flat bottom, the dimensions of the substantially flat bottom being sized to fit within each uniquely shaped recess perimeter, vertices of said triangular base being rounded;
  - (b) a grip projecting substantially perpendicularly from the base ~~in a plane substantially perpendicular to the plane of the base~~; and
  - (c) an oblong shaped mounting hole ~~in~~ recessed within the base for receiving the retaining screw.
2. (Currently Amended) The cleat of claim 1 wherein the area of the base is smaller than the areas of each of the recesses so that in the absence of the retaining fastener, ~~the~~ a cleat can wiggle in ~~the~~ a recess.
3. (Original) The cleat of claim 1 wherein the ratio of the length of the mounting hole to width of the mounting hole is from about 8:7 to about 10:7
4. (Currently Amended) A baseball shoe comprising:
  - (a) a sole;



- (b) multiple recesses in the sole sized for receiving a cleat;
- (c) a threaded opening in each recess;
- (d) a cleat mounted in at least some of the recesses, at least one cleat being a universal cleat comprising (i) a generally triangular base with a substantially flat bottom, the dimensions of the substantially flat bottom being sized to fit within a plurality of differently shaped recess perimeters, (ii) a grip projecting from the base in a plane substantially perpendicular to the plane of the base, and (iii) a mounting hole in the base, at least one of the mounting holes being oblong shaped; and
- (e) a retaining fastener for each cleat extending through the mounting hole and threaded into the respective threaded opening for retaining the respective cleat in place.

5. (Previously presented) The shoe of claim 4 wherein the area of the base of each universal cleat is smaller than the area of the respective recess so that in the absence of the retaining fastener, the cleat wiggles in the recess.

6. (Original) The shoe of claim 4 wherein the ratio of the length of each oblong shaped mounting hole to the width of the oblong shaped mounting hole is from about 8:7 to about 10:7.

7. (Original) The shoe of claim 4 wherein all of the cleats are universal cleats.

8. (Original) The cleat of claim 2 wherein the area of the base is from 85 to 95% of the area of the recess.

9. (Original) The shoe of claim 5 wherein the area of the base is from 85 to 95 % of the area of the recess.

10. (Currently Amended) A universal cleat usable in any one of a plurality of differently configured athletic shoes furnished by different manufacturers, all of said shoes sharing the common characteristic of the bottom of each shoe of said plurality having at least one generally triangularly configured cleat mounting surface with an upstanding border defining a recess for receiving said cleat with a threaded receptacle positioned within said recess for receiving a retaining screw to hold the cleat in place, with said triangularly configured cleat mounting surfaces all having at least two of the three sides being of equal length, said receptacle being positioned closer to the vertices of said triangularly configured surfaces which would be defined by intersection of said sides of equal length than to the remaining vertices of said triangularly configured surfaces, said cleat comprising:

- (a) a generally triangular ~~planar~~ one piece molded plastic base having a bottom planar surface adapted for facing contact with said cleat mounting surfaces of said shoes of said plurality, with a longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses in any of said shoes of said plurality;
- (b) a grip projecting perpendicularly from the base in a direction oppositely from that of a plane defined by the base planar surface portion; and

- (c) an oblong aperture in the planar portion of said base for passage therethrough of said retaining screw.

11. (Currently Amended) A universal cleat usable in any one of a plurality of differently configured athletic shoes furnished by different manufacturers, all of said shoes sharing the common characteristic of the bottom of each shoe of said plurality having at least one generally triangularly configured cleat mounting surface with an upstanding border defining a recess for receiving said cleat with a threaded receptacle positioned within said recess for receiving a retaining screw to hold the cleat in place,

- (a) a first shoe of said plurality furnished by a first one of said manufacturers having formed in the bottom exterior surface an equilateral three sided recess formed about said receptacle, sides of said recess extending transversely outwardly from said shoe bottom exterior surface, vertices of said recess being rounded, two of said sides being linear and a third side defining an inset inboard of a line which if drawn would connect two of said vertices in a manner identically to that of said linear sides;
- (b) a second shoe of said plurality furnished by a second one of said manufacturers having a generally equilaterally triangularly shaped portion extending outwardly respecting said sole with sides of said triangular raised portions sloping inwardly relative to the triangular shape with increasing distance from said sole, with vertices of said triangle being rounded, with outer edges of two of said sides being linear and an outer edge of a third side defining an inset inboard of

a line which if drawn would connect two of said vertices in a manner identically to that of said linear side, with the triangularly shaped portion being positioned about said threaded receptacle formed in said sole with said receptacle substantially midway between the center of said triangular shape and a vertex connecting said two linear edges;

- (c) a third shoe furnished by a third one of said manufacturers having a generally isosceles triangular shaped recess formed about said receptacle with vertices of said recess being rounded and sides of said recess being linear with the two equal length sides being substantially the length of said linear sides of said recesses in said first and second shoes of said plurality as furnished by said first and second manufacturers, said third side being longer than said equal length sides; and
- (d) a fourth shoe furnished by a fourth one of said manufacturers having a portion of generally triangular configuration raised transversely from said sole and surrounding said threaded receptacle adjacently to where one vertex of said triangular configuration would be if two sides of said triangle leading theretowards were extended to intersect, said two sides of said triangular configuration being of equal length and connected by a continuous arc swung about said receptacle, said two equal length sides of said triangular configuration which if extended to intersect

would be defined by vertices, terminating short of intersection and being connected by straight line edges of said portion to a third side of said triangular configuration and including an upstanding lip bordering said triangular portion remote from said receptacle with edge portions of said lip bounding said two equal length sides of said triangular portion stopping short of intersection;

said cleat comprising:

- (i) a generally triangular one piece molded plastic base with a longest side of said three sides of said base being shorter than the longest side of said triangular recesses in any of said shoes of said plurality;
- (ii) a grip projecting from the base in a plane substantially perpendicular to the ~~plane~~ bottom of the base; and
- (iii) an oblong aperture in the base for passage therethrough of said retaining screw.

12. (Previously Presented) The cleat of claim 11 wherein said longest side of said three sides of said base is shorter than the shortest of said two equal length sides of said triangular configuration of any of said shoes of said plurality.

13. (Previously Presented) The cleat of claim 11 wherein the area of said base is smaller than the smallest area of the recess of any of the shoes of said plurality so that in the absence of the retaining fastener, the cleat may wiggle within the recess.

14. (Previously Presented) The cleat of claim 11 wherein the ratio of length to width of the oblong aperture is from about eight to seven (8:7) to about ten to seven (10:7).

15. (Currently Amended) A universal cleat usable in any one of a plurality of differently configured baseball shoes furnished by different manufacturers, the bottom of each shoe of said plurality having at least one generally triangularly configured recess with a threaded receptacle positioned within each said recess for receiving a retaining screw to hold the cleat in place, comprising:

- (a) a generally triangular one piece molded plastic base with a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses in any of said shoes of said plurality;
- (b) a grip projecting perpendicularly from the base ~~in a plane substantially perpendicular to the plane of the base~~; and
- (c) an oblong aperture in the base separated from the grip for passage therethrough of said retaining screw.

16. (Previously Presented) The cleat of claim 15 wherein the area of said base is smaller than the smallest area of the recess of any of the shoes of said plurality so that in the absence of the retaining fastener, the cleat may wiggle within the recess.

17. (Previously Presented) The cleat of claim 15 wherein the ratio of length to width of the oblong aperture is from about eight to seven (8:7) to about ten to seven (10:7).

18. (Currently Amended) A universal cleat usable in any one of a plurality of differently configured baseball shoes furnished by different manufacturers, the bottom of each shoe of said plurality having a plurality of cleat-receiving recesses, each of said recesses having at least three sides defined by straight lines, with a threaded receptacle positioned within each said recess for receiving a retaining screw to hold the cleat in place, comprising:

- (a) a one piece generally triangular molded plastic base with a longest side being shorter than the longest of any of said straight line sides of said recesses in said shoes of said plurality;
- (b) a grip projecting perpendicularly from the base ~~in a plane~~ substantially perpendicular to the plane of the base; and
- (c) an oblong aperture in the base for passage therethrough of said retaining screw.

19. (Currently Amended) A baseball shoe comprising:

- (a) a sole;
- (b) a plurality of generally triangular recesses formed on said sole for receiving cleats, each recess having at least one generally triangularly configured cleat mounting surface with an upstanding border defining a recess for receiving a cleat, with a threaded receptacle positioned within said recess for receiving a retaining screw to hold the cleat in place, with said triangularly configured cleat mounting surfaces all having at least two of the three sides being of equal length, said receptacle in each recess being

positioned closer to the vertices of said triangularly configured surfaces which would be defined by intersection of said sides of equal length than to the remaining vertices of said triangularly configured surfaces;

(c) cleats mounted in at least some of said recesses, at least one of said cleats being a universal cleat including:

- (i) a one piece generally triangular plastic base with a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses;
- (ii) a grip projecting perpendicularly from the base ~~in a plane substantially perpendicular to the plane of the base~~; and
- (iii) an oblong aperture in the base for passage therethrough of said retaining screw.

20. (Previously Presented) The shoe of claim 19 wherein the area of the base of each universal cleat is less than the area of the respective recess so that in the absence of a retaining screw said universal cleat may wiggle in said recess.

21. (Previously Presented) The shoe of claim 19 wherein all of said cleats are said universal cleats.

22. (Previously Presented) The shoe of claim 19 wherein the area of a universal cleat base is from eighty-five percent (85%) to ninety-five percent (95%) of the respective recess.

23. (Previously Presented) A baseball shoe comprising:

- (a) a sole;



- (b) a plurality of generally triangular recesses formed on said sole each for receiving a cleat;
- (c) a threaded opening in each of said recesses;
- (d) cleats mounted in at least some of said recesses, at least one of said cleats being a universal cleat including:
  - (i) a generally triangular base with a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses in said sole;
  - (ii) a grip projecting from the base in a plane substantially perpendicular to the plane of the base; and
  - (iii) an oblong aperture in the base for passage therethrough of said retaining screw.

24. (Previously Presented) The shoe of claim 23 wherein the area of the base of each universal cleat is less than the area of the respective recess so that in the absence of a retaining screw said universal cleat may wiggle in said recess.

25. (Previously Presented) The shoe of claim 23 wherein all of said cleats are said universal cleats.

26. (Previously Presented) The shoe of claim 23 wherein the area of a universal cleat base is from eighty-five percent (85%) to ninety-five percent (95%) of the respective recess.

**Remarks in Support of Patentability**

The examiner states that "it is not clear whether the applicant intends to claim the combination of a cleat and the baseball shoe or is claiming the subcombination of the cleat for use with the baseball shoe." Applicant regrets any confusion caused to the examiner by the manner in which the claims are drawn. Applicant respectfully submits that when the claims are read carefully, it is abundantly clear that in some instances applicant is claiming a cleat having universal application and being suitable for use with the plurality of different athletic shoes. This is the subject matter recited in independent claim 1 and in claims 2, 3 and 8, all of which depend, directly or indirectly, from independent claim 1.

In other instances applicant is claiming "a baseball shoe". This is the case with independent claim 4, which recites "a baseball shoe comprising ...". This is also the case with dependent claims 5, 6, 7 and 9 all of which depend, directly or indirectly, from independent claim 4.

Applicant has further included claims directed to "a universal cleat usable in any one of plurality of differently configured *athletic* shoes furnished by different manufacturers...". Claim 10 is one such claim. Claim 10 is clearly directed to a universal cleat which may be used in any one of a number of different athletic shoes, having different configurations, furnished by different manufacturers. The important thing is that claim 10 is directed to the cleat. The structure recited in the preamble of claim 10 is environmentally limiting structure included to identify and specify the function fulfilled by the cleat. The same is true of claim 11, 12, 13 and 14, all of which depend from claim 10.

Claim 15 similarly recites “a universal cleat usable in any one of a plurality of differently configured baseball shoes furnished by different manufacturers...”.

Accordingly, claim 15 is more limited than claims 10 through 14. Claim 15 limits the universal cleat to one which is usable in *baseball shoes furnished by different manufacturers*. Once again, the claim is directed to the cleat, not to the shoe. The shoe structure is included in the claim preamble only to provide an environmental limitation for the cleat, which is the subject matter to which the claim is directed. The same is true of claims 16 and 17, both of which depend from claim 15.

Claim 18 is similar to claim 15 in that it recites “a universal cleat usable in any one of a plurality of differently configured baseball shoes furnished by different manufacturers...”. Claim 19 is directed to “a baseball shoe” as are dependent claims 20, 21 and 22 all of which depends from claim 19. In claim 19 the cleat is recited as a part of the shoe.

Claim 23 is directed to a baseball shoe and in that regard is similar to claim 19. Claims 24, 25 and 26 all depend from claim 23 and, accordingly, are additionally directed to baseball shoes having the inventive cleats mounted in or mountable in those shoes.

Applicant believes the foregoing clarifies the situation and should eliminate the examiner’s apparent confusion regarding the subject matter to which the claims are drawn.

Further respecting this issue and the examiner’s comments, the examiner has asserted that “in many instances claims which appear to be drawn only to the subcombination of the cleat (no baseball shoe has been claimed), are further structural and limited with reference to the baseball shoe.” It is not the case that no baseball shoe

has been claimed, as evidenced by the foregoing. There are numerous claims which are directed to a baseball shoe.

The examiner has further stated by example that claim 1, in line 1, appears to clearly indicate that no baseball shoe is claimed and further asserts that “the claim is drawn to a cleat for use with a baseball shoe.”<sup>1</sup> This is incorrect. In claim 1 the word “baseball” does not even appear. The claim is drawn to “a universal cleat suitable for use with a plurality of different *athletic* shoes...”. The examiner is encouraged to re-read claim 1 whereupon the examiner will find that there is no mention of the word “baseball” or any “baseball shoe” in claim 1.

The examiner has further asserted that claim 2 recites limitations which are dependent on the size of the recess in the “baseball shoe”. Again, this is incorrect, there is no recitation in claim 2 of any limitation relating to a baseball shoe. While there are limitations relating to the relationship between the recesses in the shoe soles and the base of the cleat, applicant believes this is an appropriate way to claim this aspect of the invention. Applicant does not believe this amounts to any type of error.<sup>2</sup>

The examiner further states that “with respect to claims such as claims 2 and 16 the claims actually appear to recite that there is a baseball shoe while also appearing (at least from the preamble thereof) to be drawn only to the subcombination of the cleat for use with the baseball shoe.” Part of this statement is true; part of this statement is not true. The word “baseball” does not appear in claim 1 or claim 2 but it does appear in claim 16 (by virtue of claim 16 depending from claim 15). Hence, claim 2 does not recite

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<sup>1</sup> Last full sentence, page 3, official action of 2 February 2005.

<sup>2</sup> The first sentence at the top of page 4 of the official action of 2 February 2005 indicates that the claims have “this type of error” running therethrough. Applicant does not agree and cannot find such errors within the claims.

that there is a baseball shoe involved, the examiner's view notwithstanding, whereas claim 16 clearly does contemplate presence of a baseball shoes. Indeed, claim 15, from which claim 16 depends, recites "a universal cleat usable in any one of a plurality of differently configured *baseball* shoes...". Hence, claim 15 is directed to a cleat usable with different baseball shoes; the subject matter of the claim is that of the cleat, not of the shoes. The same is true of claims 16 and 17, both of which depend from claim 15.

Applicant respectfully submits that in every case the examiner should treat the preambles of the claims as defining the environment in which the structural claim elements function.

**I. Rejection of Claims 10-26 Under 35 U.S.C. § 112, ¶ 1**

At pages 2-3 of the Office Action, Examiner states that claims 10-26 are rejected under 35 U.S.C. § 112, ¶ 1 as failing to comply with the written description requirement. Specifically, Examiner states that independent claims 10, 11, 15, 18, 19 and 25 recite structure features not supported by the specification.

For example, the examiner asserts respecting claim 10, lines 12 through 13 and claim 11, lines 40 through 41 that the limitation "with a longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses" is not described in the specification.

As a further example, the examiner asserts that claim 15, lines 6 through 7, the limitation "with the longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses" and in claim 18, lines 6 through 7, the limitation reading "with the longest side being shorter than the longest of any of said straight line sides of the recesses" and in claim 19, lines 13 through 14, the limitation

reading “a longest side of said three side of said base being shorter than the shorter side of any of said triangular recesses” and further in claim 23 that lines 8 and 9 reciting “the longest side of three sides of said base being shorter than the shortest side of any of said triangular recesses” are all allegedly new matter.

Applicant traverses this view and respectfully submits the examiner has not read the claims in light of the written specification and the drawings forming a part of the specification of the application as originally filed.

In claim 10, lines 12 and 13, the limitation “with a longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses” applies to the cleat to which the claim is directed. In looking at Figures 8, 9, 10 and 11 it is abundantly clear that the longest side of the base of cleat 10 is shorter than the longest side of any of the triangular recesses 14A, 14B, 14C and 14D of any of the shoes depicted in Figures 8, 9, 10 and 11. The specification clearly points out that the cleat base 22 is triangularly shaped and has a flat bottom 24 and that due to this configuration the cleat “can fit into different size recesses 14, including recesses that have indents for receiving grips extending from the base as in conventional cleats.”<sup>3</sup> With the cleat having a generally triangular base<sup>4</sup> and with the triangular base shape facilitating fitting the base into different size recesses 14, it should be clear to any one having even a rudimentary, high school knowledge of geometry that the longest of the three sides of the triangular base must be shorter than the longest side of any of the triangular recesses, as recited in claim 10. Hence, while the precise language to which the examiner has objected admittedly does not appear verbatim in the written specification, that language

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<sup>3</sup> Specification as filed, page 4, lines 4 through 6.

<sup>4</sup> Specification, page 4, line 1

recites a structural combination which unquestionably is disclosed in the original application when the text on page 4, commencing at line 1 and running through line 6, is read in view of drawing figures 5, 6, 8, 9, 10, 11 and 12 of the application as filed. Reconsideration and withdrawal of the rejection of claim 10 under 35 USC 112, first paragraph, as allegedly failing to comply with the written description requirement is respectfully solicited.

An applicant complies with the written description requirement “by describing the invention with all its claimed limitations . . . by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.” Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572 (Fed. Cir. 1997) (emphasis added). Applicant respectfully submits that the Features are supported by the original specification in such a way as to reasonably convey to one skilled in the art that the inventor was in possession of the claimed invention at the time the application was filed. Specifically, the Features of claim 10, 11, 15, 18, 19 and 25 are clearly shown in the drawings originally filed as part of the specification.

Certain amendments to a specification do not constitute new matter. For example, an amendment is not considered new matter when it simply makes a disclosure of information that one skilled in the art would have already understood to be disclosed in the application as originally filed. See generally M.P.E.P. § 2167.07. As another example, rewording and rephrasing of previously disclosed subject matter does not constitute new matter. See, e.g., In re Anderson, 471 F.2d 1237, 1244 (C.C.P.A. 1973).

“[T]o avoid the new matter prohibition, an applicant must show that its original application supports the amended matter.” Schering Corp. v. Amgen, Inc., 222 F.3d

1347, 1352 (Fed. Cir. 2000). “The fundamental inquiry is whether the material added by the amendment was inherently contained in the original application.” Id. Applicant submits that the Features are disclosed by the originally filed drawings.

Applicant respectfully refers Examiner to the case of In re Reynolds, 443 F.2d 384 (C.C.P.A. 1971). In Reynolds, the patent application as originally filed contained a drawing that the Court held taught the features of later-added claims, even though the original specification did not contain text teaching the feature. See generally In re Reynolds, 443, F.2d 384 (C.C.P.A. 1971). In Reynolds, the applicant argued that the drawings disclosed the subject-matter of the later added claims; the examiner agreed in general with the applicant that the drawing can be used as disclosure in supporting claims but, contended that the particular drawings in Reynolds’ application did not disclose a certain geometry which was in question that the Reynolds’ position on the issue of presence of the disclosure in question and that Reynolds’ position on the issue of presence of the disclosure in question in the drawing was “merely conjecture.” The Court opined on this issue as follows:

First, we do not think [applicant’s] position is ‘mere conjecture’ in view of what is apparently a geometric certainty in Fig. 2. **We realize that a patent drawing does not have to be to any particular scale. Nevertheless, a person attempting to construct a capacitor following appellant’s disclosure would have to distort significantly the relationships show in Fig. 2 in order not to produce a device which would inherently perform the recited function. In view of the unusual shape of plate 24 and the eccentric mounting of plate 26 on shaft 17, we think a person skilled in the art would suspect that there was some reason for the relationships shown in the drawing and would not regard such disclosure as accidental or arbitrary.**



Id. at 389 (emphasis added) (cited by M.P.E.P. § 2163.07(a) for the additional proposition that a disclosure of a device in the original application can support a later amendment of a function, use or advantage of that device).

Applicant respectfully submits that the features cited by the Examiner from independent claims 10, 11, 15, 18, 19 and 25 are supported by the originally filed drawings. Generally, the features relate to the size of the longest side of the base relative to the longest side of the triangular recess. The features are disclosed at least in Figures 8-11, where it is shown that the base of the inventive cleat fits within the triangular recesses of the prior art. In order for the base of the cleat to fit within the triangular recess in the manner shown by the drawing, it is inherent geometric necessity that the longest side of the base is shorter than the longest side of the triangular recess.

Regarding dependent claims 12-14, 16, 17 and 20-24, Examiner has not expressly stated which aspect of the claim is the basis of the rejection. Applicant thus believes Examiner has rejected these claims due to the Examiner's concerns regarding the independent claims. Applicant thus respectfully traverses the rejection of dependent claims 12-14, 16, 17 and 20-24 at least for the same reasons as Applicant's traversal of independent claims 10, 11, 15, 18, 19 and 25.

Applicant respectfully requests the Examiner withdraw the rejection under 35 U.S.C. § 112 ¶ 1 and immediately allow pending claims 10-26.

## **II. Rejection of Claims 1-3, 8, 10-18 Under 35 U.S.C. § 112 ¶ 2**

At pages 3-4 of the Office Action, Examiner states that claims 1-3, 8 and 10-18 are rejected under 35 U.S.C. § 112 ¶ 2 as failing to particularly point out and identify the subject matter. Examiner states that there is confusion as to whether Applicant is

claiming the cleat or is claiming the cleat in combination with the shoe. The Examiner further indicates that Examiner will treat the claims as if the reference to the shoe is merely a statement of intended use and requested clarification.

For the record, Applicant further clarifies that the scope of the claims as follows: Claims 1-3 and 10-18 are directed to the cleat. Claims 4-9 and 19-26 are directed to a shoe having the inventive cleat. Applicant thus respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 112 ¶ 2 and immediately allow claims 1-3, 8 and 10-18.

### **III. Objection to the Specification Under 35 U.S.C. § 132**

At page 4 of the Office Action, Examiner states that the amendment of May 20, 2003, is objected to under 35 U.S.C. § 132 as adding new matter with regards to the phrase “has a generally isosceles and/or equilaterally triangular shape recess formed about the receptacle.”

Applicant traverses the objection to the amendment filed 20 May 2003 and the examiner’s assertion that such amendment added new matter to the disclosure. Applicant respectfully notes that the drawings of a patent application are a part of the disclosure. The drawings alone can be the basis for addition of descriptive material to the original written description. Indeed, the case law decisions approving of the same are legion.<sup>5</sup>

Applicant respectfully traverses this objection at least for the following reasons. The text of the May 20, 2003, amendment characterizes the four manufacturer’s shoes. The shoes themselves are prior art and this passage is characterizing the prior art. There

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<sup>5</sup> See, for example, *Cooper Cameron Corp. v. Kvaerner Oilfield Products, Inc.*, 291 F.3d 1317, 1322, 62 USPQ2d 1846 (Fed. Cir. 2002); *Scanner Technologies Corp. v. ICOS Vision Systems Corp.*, 253 F.Supp.2d 624, 633 (S.D. N.Y. 2003); *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 866, 26 USPQ2d 1767, 1774 (Fed. Cir. 1993)

is a presumption that all those skilled in the art would have all knowledge of the prior art upon reading the patent application and, thus no new matter has been added to the application.

Furthermore, Applicant respectfully submits that the cited phrase is supported by the original disclosure. As stated *supra*, the cited phrase was inherently contained in the original application as shown in at least Figures 8-11. In fact, the Applicant respectfully submits that Examiner had done exactly that which the Examiner objects to in the current Office Action. At pages 7-8, the Examiner rejects claims 1, 3-4, 6-7 and 9 by asserting that U.S. Patent 5,943,795 ("Ueda") teaches "that it is desirable to have the mounting hole oblong shape" by only referring to Figure 7 and no other written language. Office Action, page 7, lines 17-19. See also Office Action, page 8, lines 3-4 (asserting the ratio of the length of the mounting hole to the width of the mounting hole "appears" to be 8:7 to about 10:7). If the Examiner asserts Ueda teaches a limitation of the Applicant's claims by only referring to a drawing, then Examiner must agree that the drawings are part of the disclosure. Therefore, if the Examiner agrees that the drawings are part of the disclosure, then merely reciting what is already disclosed in the drawings do not constitute new matter.

Applicant further submits that what constitutes an isosceles or equilateral triangle is well-known and certainly within the purview of one of ordinary skill in the art to which this invention pertains. One of ordinary skill in the art would immediately recognize that the triangular recesses illustrated in figure 11 are essentially equilateral triangular recesses, whereas the triangular recesses illustrated in figure 8 are essentially isosceles triangular shaped recesses. Adding words to the specification, which words are the very

definitions of the shapes shown in the drawings filed with the application, does not add new matter to the specification. Applicant respectfully requests reconsideration and withdrawal of the rejection of the amendment filed 20 May 2003 as allegedly introducing new matter into the disclosure.

For at least these reasons, Applicant respectfully requests that Examiner withdraw the objection under 35 U.S.C. § 132 and allow the amendment.

#### **IV. Rejection of Claim 1 Under 35 U.S.C. 102(b)**

At pages 4-6 of the Office Action, Examiner states that claim 1 is rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 1,055,229 ("Rogers"). The Applicant respectfully traverses the rejection for at least the following reasons.

Rogers teaches a fastener for shoe sole spike plates. Rogers teaches that the cleat is attached by operation of jaws 11 by means of turnbuttons 9 and the slots 10 in said jaws. Rogers, col. 1, lines 44-47.

The claims have been amended to distinguish over the art. Claim 1 has been amended to recite that the generally triangular base of the universal cleat is "one piece molded plastic" and has "two straight sides of equal length". The oblong-shaped mounting hole has further been recited as being "recessed within" the base of the cleat for receiving a retaining screw. These structural limitations distinguish claim 1 over U.S. patent 1,055,2289 to Rogers, on which the 35 USC 102 anticipation rejection is based, since the reference does not disclose a one piece plastic base and certainly does not disclose an oblong-shaped mounting hole recessed within the base for receiving a retaining screw. Accordingly, reconsideration and withdrawal of 35 USC 102 rejection of claim 1 based on Rogers is respectfully solicited.

These amendments are further believed to distinguish claims 2 and 3, as depending from claim 1, and to render those claims unobvious in view of U.S. patent 1,055,229 to Rogers. Rogers does not suggest any cleat fitting within a recess and therefore cannot suggest a cleat having a base “smaller than the areas of each of the recesses” as recited in claim 2.

Moreover, Rogers does not suggest any numerical ratio of the length of the mounting hole to the width of the mounting hole as recited in claim 3; indeed, Rogers does not even disclose any mounting hole, let alone one which is recessed into the base for receiving a retaining screw. The aperture appearing in Rogers is simply an area where material has been removed from the spike assembly to reduce the weight of the assembly and has nothing at all to do with mounting the assembly on a shoe.

As respecting claim 8, there is no recess indicated or disclosed by Rogers and therefore claim 8, reciting a ratio between the area of the base and the area of the recess, is not rendered obvious by Rogers, especially in light of the fact that claim 8 depends from claim 2 which in turns depends from claim 1 as amended.

The Applicant respectfully submits that Rogers does not anticipate the Applicant's independent claim 1. Specifically, Applicant's independent claim 1 recites a universal cleat comprising an oblong shaped mounting hole in the base for receiving the retaining screw. The hole is oblong shaped to accommodate the fact that the mounting holes in the various shoes are not all in the same location relative to the periphery of the base. Applicant's Specification, p. 4, lines 13-20.

Rogers fails to teach, show or suggest a universal cleat comprising an oblong shaped mounting hole in the base for receiving the retaining screw. In contrast, Rogers

teaches adjustable slots on the jaws 11 and not the base ball spike plate 1 (i.e. the cleat). Rogers, col. 1, lines 44-47; Figs. 1-2 (emphasis added). Therefore, Johnson clearly does not anticipate Applicant's independent claim 1 and the Applicant respectfully request the rejection be withdrawn.

#### **V. Rejection of Claims 1-9 Under 35 U.S.C. 103(a)**

##### **A. Claims 2, 3 and 8**

At pages 6-7 of the Office Action, Examiner states that claims 2, 3 and 8 are rejected under 35 U.S.C. § 103(a) as being obvious over Rogers. The Applicant respectfully traverses the rejection for at least the following reasons.

The teachings of Rogers are discussed above. Rogers fails to teach, show or suggest a universal cleat comprising an oblong shaped mounting hole in the base for receiving the retaining screw, as positively claimed by Applicant's independent claim 1. In contrast, Rogers teaches adjustable slots on the jaws 11 and not the base ball spike plate 1 (i.e. the cleat). Rogers, col. 1, lines 44-47; Figs. 1-2 (emphasis added).

Therefore, independent claim 1 is clearly patentable over Rogers.

Moreover dependent claims 2, 3 and 8 depend, either directly or indirectly, from independent claim 1 and recite additional limitations. Therefore, for at least the same reasons discussed above, dependent claims 2, 3 and 8 are also patentable over Rogers. As such, the Applicant respectfully requests the rejection be withdrawn.

##### **B. Claims 1, 3-4, 6-7 and 9**

At page 8 of the Office Action, Examiner states that claims 1, 3, 4, 6, 7 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patents 5,058,292

("Tanel"), 4,590,693 ("Kawashima") and 5,943,795 ("Ueda"). The Applicant respectfully traverses the rejection for at least the following reasons.

Tanel teaches a cleat for an athletic shoe. Tanel teaches that the cleat is bonded to the shoe. Tanel, col. 8, lines 66-68. Kawashima teaches a baseball or softball shoe sole. Kawashima teaches a generally square shaped cleat. Kawashima, Fig. 1. The cleats are attached using an internally threaded fitting. Kawashima, col. 2, lines 15-17. Ueda teaches a bicycle shoe. Ueda teaches that the sole of the bicycle shoe is provided with one or more attachment apertures so that the shoe can be used with either a road bicycle or a mountain bicycle. Ueda, Abstract.

The Applicant respectfully submits that Tanel, Kawashima and Ueda, alone or in any permissible combination, do not teach, show or suggest the Applicant's amended independent claims 1 and 4. Specifically, Applicant's independent claims 1 and 4 recite a cleat comprising a generally triangular base with a substantially flat bottom, the dimensions of the substantially flat bottom being sized to fit within differently shaped recess perimeters. The dimensions of the cleat, in combination with the oblong shaped mounting hole allow the cleat to be compatible with differently shaped recess perimeters. Applicant's Specification, Summary.

Tanel completely fails to teach, show or suggest a cleat comprising a generally triangular base with a substantially flat bottom, the dimensions of the substantially flat bottom being sized to fit within differently shaped recess perimeters. Tanel clearly teaches away from the Applicants invention because Tanel teaches that each cleat is bonded to the sole. Tanel, col. 8, lines 66-67 (emphasis added). Therefore, the cleat taught in Tanel can only be used with a shoe manufactured for the specific cleat disclosed

in Tanel. Kawashima and Ueda fail to bridge the significant divide left by Tanel. Kawashima only teaches a generally square shaped cleat attached with an internally threaded fitting. Kawashima, col. 2, lines 15-17; Fig. 1 (emphasis added). Ueda only teaches a shoe that is compatible with a variety of cleats. Ueda, Abstract (emphasis added). In fact, Ueda teaches away from the Applicant's invention because Ueda teaches a shoe that is compatible with a variety of cleats and not a cleat compatible with a variety of shoes as claimed by the Applicant's independent claims 1 and 4. Id.

Assuming arguendo that it were proper to combine Tanel, Kawashima and Ueda, which Applicant does not admit, the combination of Tanel, Kawashima and Ueda fail to teach, show or suggest the Applicant's invention. Combining Tanel, Kawashima and Ueda only teaches a shoe manufactured to be compatible with either a triangular or square cleat fitted by a threaded screw. The combination of Tanel, Kawashima and Ueda do not teach a cleat comprising a generally triangular base with a substantially flat bottom, the dimensions of the substantially flat bottom being sized to fit within differently shaped recess perimeters, as positively claimed by the Applicant's independent claims 1 and 4.

Moreover, Applicant respectfully submits that Examiner is using impermissible hindsight because there is no motivation to combine the teachings of Tanel, Kawashima and Ueda. Tanel and Kawashima clearly teach inventions related to baseball cleats. In contrast, Ueda clearly teaches an invention related to a biking shoe. The Applicant submits one of ordinary skill in the art of baseball cleats would not look to a biking shoe because of their inherently different design, properties and function. There is no suggestion or motivation to combine Tanel, Kawashima and Ueda. Therefore,



Applicant's independent claims 1 and 4 are clearly patentable over Tanel, Kawashima and Ueda.

Moreover, dependent claims 3, 6, 7 and 9 depend, either directly or indirectly, from independent claims 1 and 4, respectively, and recite additional limitations. Therefore, for at least the same reasons discussed above, dependent claims 3, 6, 7 and 9 are also patentable over Tanel, Kawashima and Ueda. As such, the Applicant respectfully requests the rejection be withdrawn.

C. Claims 2, 5, 8 and 9

At page 8 of the Office Action, Examiner states that claims 2, 5, 8 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanel, Kawashima and Ueda and further in view of U.S. Patents 4,523,396 ("Dassler"). The Applicant respectfully traverses the rejection for at least the following reasons.

The teachings of Tanel, Kawashima and Ueda are discussed above. Dassler teaches an athletic shoe having spike or stud-shaped cleats exchangeably arranged at the running sole. Base parts of the spike or stud shaped cleats are inserted into an opening by means of a sliding or pressing fit. Dassler, col. 4, lines 16-22. The cleat is further secured with a shaft inserted through a continuous bore hole so that all of the cleats of a row are fastened jointly. Id. at lines 49-61.

The Applicant respectfully submits that Tanel, Kawashima, Ueda and Dassler, alone or in any permissible combination, do not teach, show or suggest the Applicant's amended independent claims 1 and 4. Specifically, Applicant's independent claims 1 and 4 recite a cleat comprising a generally triangular base with a substantially flat bottom, the dimensions of the substantially flat bottom being sized to fit within differently shaped

recess perimeters. The dimensions of the cleat, in combination with the oblong shaped mounting hole allow the cleat to be compatible with each differently shaped recess perimeter. Applicant's Specification, Summary.

Tanel completely fails to teach, show or suggest a cleat comprising a generally triangular base with a substantially flat bottom, the dimensions of the substantially flat bottom being sized to fit within differently shaped recess perimeters. Tanel clearly teaches away from the Applicants invention because Tanel teaches that each cleat is bonded to the sole. Tanel, col. 8, lines 66-67 (emphasis added). Therefore, the cleat taught in Tanel can only be used with a shoe manufactured for the specific cleat disclosed in Tanel. Kawashima, Ueda and Dassel fail to bridge the significant left by Tanel. Kawashima only teaches a generally square shaped cleat attached with an internally threaded fitting. Kawashima, col. 2, lines 15-17; Fig. 1 (emphasis added). Ueda only teaches a shoe that is compatible with a variety of cleats. Ueda, Abstract (emphasis added). In fact, Ueda teaches away from the Applicant's invention because Ueda teaches a shoe that is compatible with a variety of cleats and not a cleat compatible with a variety of shoes as claimed by the Applicant's independent claims 1 and 4. Id. Dassel only teaches spike or stud shaped cleats that can be inserted into openings by means of a sliding or pressing fit that are further secured by a shaft inserted through a continuous borehole. Dassel, col. 4, lines 16-22, 49-61.

Assuming arguendo that it were proper to combine Tanel, Kawashima, Ueda and Dassel, which Applicant does not admit, the combination of Tanel, Kawashima, Ueda and Dassel fail to teach, show or suggest the Applicant's invention. Combining Tanel, Kawashima, Ueda and Dassel only teaches a shoe manufactured to be compatible with

either a triangular or square cleat fitted by a threaded screw or by means of a sliding or pressing fit, wherein the cleat is further secured with a shaft inserted through borehole.

The combination of Tanel, Kawashima, Ueda and Dassel do not teach a cleat comprising a generally triangular base with a substantially flat bottom, the dimensions of the substantially flat bottom being sized to fit within differently shaped recess perimeters, as positively claimed by the Applicant's independent claims 1 and 4.

Moreover, Applicant respectfully submits that Examiner is using impermissible hindsight because there is no motivation to combine the teachings of Tanel, Kawashima and Ueda. Tanel and Kawashima clearly teach inventions related to baseball cleats. In contrast, Ueda clearly teaches an invention related to a biking shoe. Dassel clearly teaches an invention related to a running shoe. Furthermore, Dassel teaches away from Tanel and Kawashima because Dassel teaches arranging the cleats in a horizontal fashion and Tanel and Kawashima teach arranging the cleats in a circular fashion. The Applicant submits one of ordinary skill in the art of baseball cleats would not look to a biking shoe or running shoe because of their inherently different design, properties and function.

There is no suggestion or motivation to combine Tanel, Kawashima, Ueda and Dassel.

Therefore, Applicant's independent claims 1 and 4 are clearly patentable over Tanel, Kawashima, Ueda and Dassel.

Moreover, dependent claims 2, 5, 8 and 9 depend, either directly or indirectly, from independent claims 1 and 4, respectively, and recite additional limitations.

Therefore, for at least the same reasons discussed above, dependent claims 2, 5, 8 and 9 are also patentable over Tanel, Kawashima, Ueda and Dassel. As such, the Applicant respectfully requests the rejection be withdrawn.

**CONCLUSION**

Applicant believes that Applicant has fully responded to the Examiner's concerns and that all of the pending claims are in condition for immediate issuance. Applicant respectfully requests immediate issuance of all pending claims.

To the extent there is any fee required in connection with the receipt, acceptance and/or consideration of this paper and/or any accompanying papers submitted herewith, please charge all such fees to Deposit Account 50-1943.

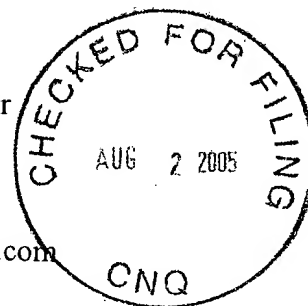
Applicant requests that any questions concerning this matter be directed to the undersigned at (215) 299-2135.

Respectfully submitted,

Date: 2 August 2005

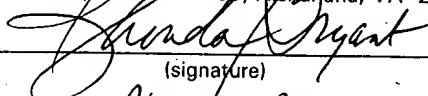


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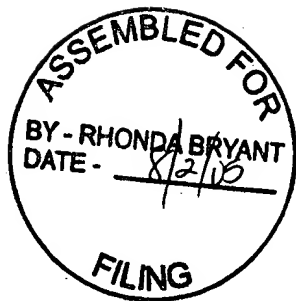
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UNDER 37 C.F.R. 1.8(a)**

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(signature)

BY: RHONDA BRYANT

DATE: AUGUST 2 2005





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81699.15001

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/771,416

01/26/2001

Daniel Pellerin

13493

6341

34661

7590

10/20/2005

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EXAMINER

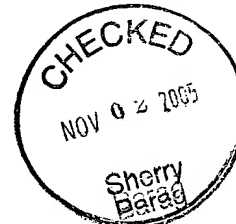
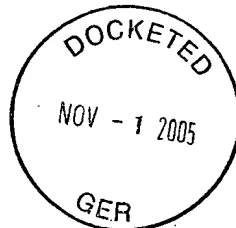
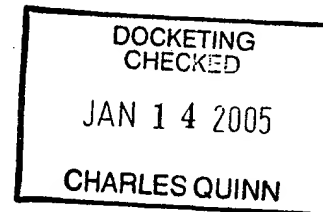
MOHANDESI, JILA M

ART UNIT PAPER NUMBER

3728

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



RESPONSE FILED:  
Date 4/20/04 By GR  
DOCKETING SATISFIED:  
Date 4/21/04 By AB  
IP GROUP  
FOX ROTHSCHILD LLP

OCT 25 2005

Q

## Office Action Summary

**Application No.**

09/771,416

**Applicant(s)**

PELLERIN, DANIEL

**Examiner**

Jila M. Mohandesi

**Art Unit**

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 1, line 6, the limitation "one piece molded plastic", In claim 10, lines 12-13 and claim 11, lines 40-41, the limitation "with a longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses" and claim 15, lines 6-7, the limitation "with a longest side of said three sides of said base being shorter than the shortest side of any said triangular recesses", and claim 18, lines 6-7, the limitation "with a longest side being shorter than the longest of any of said straight line sides of the recesses", claim 19, lines 13-14, the limitations a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses" and claim 23, lines 8-9, the limitation "a longest side of said three sides of said base being shorter than the shortest side of any of said triangular recesses" are new matter. These limitations are not described in the original specification in such a way as to reasonably convey to one skilled in the relevant art that

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the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to the phrase "with a longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses" Applicant has no support to claim it this way because this is only one possibility and not the only possibility that the Figures depict. Furthermore, since Figures 8-11 do not show the universal cleat completely sitting in the recess and the original specification does not teach the universal cleat completely fitting into the recess, it will not be clear to one skilled in the art that the longest side of said three sides of said base being shorter than the longest side of any of said triangular recesses since the cleat can be partially fitted into the recess and therefore, the longest side of the three sides of said base could be longer than the longest side of any of said triangular recesses.

With respect to phrase "with a longest side of said three sides of said base being shorter than the shortest side of any said triangular recesses" the Figures do not teach this feature and the original specification does not contain text teaching this feature. It is not clear from the Figures as whether the longest side of said three sides of said base is shorter or longer or the same length of the shortest side of any said triangular recesses.

With respect to the phrase "with a longest side being shorter than the longest of any of said straight line sides of the recesses", the Figures do not teach this feature and the original specification does not contain text teaching this feature, and since it is not clear where the straight line side ends and where the curved line side starts and what the actual length of the straight line side is?



***Specification***

3. The amendment filed May 20, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The phrase "has a generally isosceles and /or equilaterally triangular shape recess formed about the receptacle" is not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Contrary to applicant's arguments Figures 8-11 do not depict these new limitations.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the phrase "triangular base having two straight sides of equal length" is vague and indefinite. It is not clear as what part of the side is considered to be the straight side. It is not clear as where the straight sides ends and where the curved sides starts on the side of the triangle.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 and 8 are rejected under 35 U.S.C. 103(a) as being obvious over Rogers (1,055,229). Rogers `229 discloses a cleat for a baseball shoe comprising:

- a) a generally triangular base (baseball spike plate 1) with substantially flat bottom;
- b) a grip projecting from the base in a plane substantially perpendicular to the plane of the base (See Figure 1 embodiment);
- c) an oblong shaped mounting hole in the base.

All the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed, *Ex parte Masham* 2 USPQ2nd 1674. Also *Ex parte Casey* 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has

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all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

The oblong shape mounting hole of Rogers '229 is inherently capable of receiving a retaining screw.

With respect to claims 2 and 8, it would have been an obvious matter of design choice to modify the size of the base of the cleat since such a modification would have involved a mere change in the size and shape of a component. A change in size and shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955) and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

With regard to claim 3, the ratio of the length of the mounting hole to the width of the mounting hole would be a design choice depending on the shape and size of the mounting hole.

With respect to the material of the cleat, since applicant has not disclose any criticality in the type of material being used, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the material of the cleat, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

8. Claims 1, 3-4 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanel (5,058,292) in view of Kawashima et al. (4,590,693) and Ueda et al. (5,943,795). Tanel '292 discloses an universal cleat suitable for use for multiple

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different baseball shoes, the shoes having a recess in the sole (column 8, lines 63-66) for receiving a cleat, the cleat comprising a generally triangular base (11) with a substantially flat bottom for fitting into a plurality of different shaped recesses in different shoes (column 9, lines 1-3); a grip (13) projecting from the base in a plane substantially perpendicular to the plane of the base; and a mounting hole (29) in the base, the mounting hole can have any convenient shape (column 7, line 6-8). Tanel '292 does not appear to have a threaded opening in the recess for receiving a retaining screw to hold the cleat in place and for the mounting hole to be oblong shaped. Kawashima '693 discloses a baseball shoe having a recess (5) with threaded opening (4) therein for receiving a retaining screw (9) to hold a cleat (8) in place and allow for easier replacement of the cleat. Ueda '795 discloses that it is desirable to have the mounting hole oblong shape for connecting the cleat to the sole to allow more adjustability. See Figure 7 embodiment. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a threaded opening in the recess of Tanel '292 for receiving a retaining screw as taught by Kawashima '693 to better secure the cleat to the sole. Also, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the mounting hole of Tanel '292 oblong shaped as taught by Ueda '795 to allow more adjustability.

With regard to claims 3 and 6, the ratio of the length of the mounting hole to the width of the mounting hole as modified appears to be 8:7 to about 10:7.

9. Claims 2, 5 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claims 1 and 4 above, and further in view of

Dassler (4,523,396). Tanel '292 as modified above discloses all the limitations of the claims except for the specific area of the base with respect to the area of the recess. Dassler '396 discloses a shoe with a sole having a plurality of recesses for receiving a cleat. Dassler '396 discloses that depending on the shape of the base of the cleat there is no need for the fit between the inside wall of the openings/recesses (4) and the circumference of the base parts (5) to be too close therefore allowing the cleat to wiggle in the recess in the absence of the retaining fastener. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to Make the area of the base of the cleat smaller than the area of the recess as taught by Dassler 396 for easier interchangeability of the cleats.

With regard to claims 8 and 9, it appears that the area of the base is from 85 to 95% of the area of the recess, furthermore, the relationship between the area of the base and the area of the recess will depend on the type and shape of cleat being used.

### ***Response to Arguments***

10. Applicant's arguments filed August 04, 2005 have been fully considered but they are not persuasive. Contrary to applicant's arguments Figures 8-11 do not show the new limitations considered as new matter, see above arguments. Therefore these drawings can not be the basis for addition of descriptive material not shown by these drawings to the original written description.

11. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

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hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

12. In response to applicant's argument that the bottom of the universal cleat is sized to fit within differently shaped recess perimeters, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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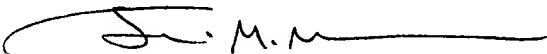
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JILA M. MOHANDESI  
PRIMARY EXAMINER**



Jila M Mohandesi  
Primary Examiner  
Art Unit 3728

JMM  
October 18, 2005

More specifically, as shown in Figs. 8-11, the manufacturers' shoes have the common characteristic that the bottom (or sole) of each shoe has at least one generally triangularly configured cleat mounting surface with an upstanding border defining a recess for receiving a cleat with a threaded receptacle positioned within the recess for receiving a retaining screw to hold the cleat in place.

One of the shoes provided by a first one of the manufacturers has formed in the bottom exterior surface an equilateral three sided recess formed about the receptacle, sides of the recess extending transversely outwardly from the shoe bottom exterior surface, vertices of the recess being rounded, two of the sides being linear and a third side defining an inset inboard of the line which if drawn would connect two of the vertices in a manner identically to that of the linear sides.

A second shoe provided by a second one of the manufacturers has a generally equilaterally triangular shaped portion extending outwardly respecting the bottom with sides of the triangular raised portion sloping inwardly relative to the triangular shape with increasing distance from the bottom. The vertices of the triangle are rounded. Outer edges of two of the sides are triangular or linear and an outer edge of the third side defines an inset inboard of a line which if drawn would connect two of the vertices identically to that of the linear sides. The triangularly shaped portion is positioned about the threaded receptacle formed in the bottom, with the receptacle substantially midway between the center of the triangular shape and a vertex connecting the two linear edges.

A third shoe furnished by a third one of the manufacturers has a generally isosceles triangular shaped recess formed about the receptacle. Vertices of the recess are rounded and sides of the recess are linear with two equal length sides being substantially the length of the



linear sides of the recess in the first and second shoes. The third side is longer than the equal length sides.

A fourth shoe furnished by a fourth one of the manufacturers has a portion of generally triangular configuration raised transversely from the bottom and surrounding the threaded receptacle adjacently to where one vertex of the triangular configuration would be if two sides of the triangular leading theretowards were extended to intersect. The two sides of the triangular configuration are of equal length and connected by a continuous arc swung about the receptacle. The two equal length sides of the triangular configuration, if extended to intersect, would be defined by vertices, terminating short of intersection and being connected by straight line edges of the portion of generally triangular configuration, to a third side of the triangular configuration. The vertices include an upstanding lip bordering the triangular portion remote from the receptacle with edges of the lip bounding the two equal length sides of the triangular portion, stopping short of intersection.